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8 || Attorneys for Defendant
NEXTDOOR.COM, INC.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

Case No. 5:14-cv-02335-BLF

**DEFENDANT NEXTDOOR.COM, INC.'S
ANSWER AND COUNTERCLAIMS TO
FIRST AMENDED COMPLAINT
(DKT. 35)**

JURY TRIAL DEMANDED

Date Action Filed: May 20, 2014

Defendant Nextdoor.com, Inc., by and through its undersigned counsel, answers the first amended complaint of Plaintiff Fatdoor, Inc. (Dkt. 35) (the “FAC”) as follows:

PARTIES, JURISDICTION, AND VENUE

22 1. Defendant lacks knowledge or information sufficient to form a belief as to the
23 truth or falsity of the allegations of paragraph 1 of the FAC and therefore denies them.

24 2. Defendant lacks knowledge or information sufficient to form a belief as to the
25 truth or falsity of the allegations of paragraph 2 of the FAC and therefore denies them.

26 3. Defendant lacks knowledge or information sufficient to form a belief as to the
27 truth or falsity of the allegations of paragraph 3 of the FAC and therefore denies them.

28 4. Defendant lacks knowl

truth or falsity of the allegations of paragraph 4 of the FAC and therefore denies them.

5. Defendant admits that U.S. Patent Nos. 8,775,328, 8,732,091, and 8,738,545 have improperly issued and are asserted in the FAC. Defendant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations of paragraph 5 of the FAC and therefore denies them.

6. Defendant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations of paragraph 6 of the FAC and therefore denies them.

7. Defendant admits the allegations of paragraph 7 of the FAC.

8. Defendant admits that Plaintiffs purport to allege a claim of patent infringement arising under the Patent Act, 35 U.S.C. § 1 *et seq.* Defendant admits that the Court has subject matter jurisdiction over patent infringement actions pursuant to 28 U.S.C. §§ 1331 and 1338(a). Defendant lacks information sufficient to form a belief as to the truth or falsity of the remaining allegations of paragraph 8 of the FAC and therefore denies them.

9. Defendant admits that personal jurisdiction and venue are proper in this district. Defendant denies the remaining allegations of paragraph 9 of the FAC.

INTRADISTRICT ASSIGNMENT

10. Defendant admits the allegations of paragraph 10 of the FAC.

THE '328 PATENT

11. Defendant admits that Exhibit A to the FAC on its face appears to be United States Patent No. 8,775,328 (the “’328 patent”), which bears the title “GEO-SPATIALLY CONSTRAINED PRIVATE NEIGHBORHOOD SOCIAL NETWORK,” and identifies an issuance date of July 8, 2014. Defendant denies that Fatdoor is the “full owner of interest” in the ’328 patent and that the patent was duly issued. Defendant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations of paragraph 11 of the FAC and therefore denies them.

12. Defendant admits that, on its face, Claim 14 of the '328 patent includes the limitation "wherein the online neighborhood social network has a domain name of nextdoor having a generic top-top [sic] level suffix of com," which was added to the patent by Mr.

1 Abhyanker long after launch of defendant Nextdoor.com's website in a transparent attempt to
 2 claim that he invented in 2013 the website launched by Nextdoor.com in 2011. Defendant denies
 3 the remaining allegations of paragraph 12 of the FAC.

4 13. Defendant admits that, in his Notice of Allowance, Examiner Feeney erroneously
 5 agreed with Raj Abhyanker's remarks regarding the incorporation of matter from the '194
 6 application into the '328 application. Defendant denies the remaining allegations of paragraph 13
 7 of the FAC.

8 14. Defendant admits that Exhibit B on its face purports to be United States
 9 Application No. 11/603,442 (the "'442 application) and that the '442 application was published
 10 on September 20, 2007.

11 15. Defendant admits that the '442 application bears the title "MAP BASED
 12 NEIGHBORHOOD SEARCH AND COMMUNITY CONTRIBUTION."

13 16. Defendant admits that U.S. Patent Application No. 11/603,442, which is owned by
 14 Google, references the domain name nextdoor.com.

15 17. Defendant admits that Raj Vasant Abhyanker is the inventor listed on the '442
 16 application.

17 18. Defendant lacks information sufficient to form a belief as to the truth or falsity of
 18 the allegations of paragraph 18 of the FAC and therefore denies them.

19 19. Defendant lacks information sufficient to form a belief as to the truth or falsity of
 20 the allegations of paragraph 19 of the FAC and therefore denies them.

21 20. Defendant lacks information sufficient to form a belief as to the truth or falsity of
 22 the allegations of paragraph 20 of the FAC and therefore denies them.

23 21. Defendant lacks information sufficient to form a belief as to the truth or falsity of
 24 the allegations of paragraph 21 of the FAC and therefore denies them.

25 22. Defendant lacks information sufficient to form a belief as to the truth or falsity of
 26 the allegations of paragraph 22 of the FAC and therefore denies them.

27 23. Defendant denies the allegations of paragraph 23 of the FAC.

28 24. Defendant admits that, during prosecution, Examiner Feeney erroneously stated:

1 “Applicant and the Examiner discussed the claims and support in the prior applications & agreed
2 that the claimed subject matter is also supported in the parent applications.” Defendant lacks
3 information sufficient to form a belief as to the truth or falsity of the remaining allegations of
4 paragraph 24 of the FAC and therefore denies them.

5 25. Defendant admits that, during prosecution, Examiner Feeney erroneously stated:
6 “The Examiner agrees with Applicant’s remarks regarding the incorporation of the matter from
7 parent application 11/653,194, which is a continuation in part of application 11 /603,442 is proper
8 and does not add any new matter to the instant application.” Defendant lacks information
9 sufficient to form a belief as to the truth or falsity of the remaining allegations of paragraph 25 of
10 the FAC and therefore denies them.

11 26. Defendant admits that the '328 patent purports to be a continuation-in-part of the
12 '194 application. Defendant denies the remaining allegations of paragraph 26 of the FAC.

13 27. Defendant lacks information sufficient to form a belief as to the truth or falsity of
14 the remaining allegations of paragraph 27 of the FAC and therefore denies them.

15 28. Defendant lacks information sufficient to form a belief as to the truth or falsity of
16 the remaining allegations of paragraph 28 of the FAC and therefore denies them.

17 29. Defendant admits that, on its face, the '328 patent does not include a terminal
18 disclaimer. Defendant denies the remaining allegations of paragraph 29 of the FAC.

19 ||| 30. Defendant denies the allegations of paragraph 30 of the FAC.

THE '091 PATENT

21 31. Defendant admits that Exhibit C to the FAC on its face appears to be United States
22 Patent No. 8,732,091 (the “’091 patent”), which bears the title “SECURITY IN A GEO-
23 SPATIAL ENVIRONMENT,” and identifies an issuance date of May 20, 2014. Defendant
24 denies that Plaintiff Fatdoor is the full owner of interest in the ’091 patent and that the patent was
25 duly issued. Defendant lacks knowledge or information sufficient to form a belief as to the truth
26 or falsity of the remaining allegations of paragraph 31 of the FAC and therefore denies them.

THE '545 PATENT

28 | 32. Defendant admits that Exhibit D to the FAC on its face appears to be United States

1 Patent No. 8,738,545 (the “’545 patent”), which bears the title “MAP BASED
 2 NEIGHBORHOOD SEARCH AND COMMUNITY CONTRIBUTION,” and identifies an
 3 issuance date of May 27, 2014. Defendant denies that Plaintiff Fatdoor is the full owner of
 4 interest in the ’545 patent and that the patent was duly issued. Defendant lacks knowledge or
 5 information sufficient to form a belief as to the truth or falsity of the remaining allegations of
 6 paragraph 32 of the FAC and therefore denies them.

7 DEFENDANT’S ACTIVITIES

8 33. Defendant admits that Exhibit E to the FAC purports to be screenshots of
 9 Defendant’s demo website. Defendant denies the remaining allegations of paragraph 33 of the
 10 FAC.

11 34. Defendant denies the allegations of paragraph 34 of the FAC.

12 35. Defendant denies the allegations of paragraph 35 of the FAC.

13 36. Defendant admits that Raj Abhyanker (“Abhyanker”), purportedly acting on behalf
 14 of Fatdoor, contacted Defendant on May 27, 2014 and on July 8, 2014, and that these
 15 communications are reproduced in Exhibits G and H, respectively. Defendant denies that these
 16 requests have gone largely ignored, as Defendant has offered to permit Abhyanker and Fatdoor to
 17 withdraw their claims without Defendant seeking sanctions or attorneys’ fees owed to Defendant
 18 for Abhyanker’s litigation misconduct, including bringing unsupported claims in bad faith,
 19 tampering of evidence submitted to the Court and making false statements to the Court.

20 Defendant further denies that Fatdoor and/or Abhyanker own the patents that Fatdoor purports to
 21 offer to license because to the extent that any valid patent rights exist, Fatdoor and Abhyanker are
 22 not entitled to ownership rights in those patents. Defendant denies the remaining allegations of
 23 paragraph 36 of the FAC.

24 37. Defendant denies the allegations of paragraph 37 of the FAC.

25 CAUSE OF ACTION (WILLFUL INFRINGEMENT OF ’328 PATENT)

26 38. Defendant incorporates and restates its responses to the allegations set forth in
 27 paragraphs 1 through 37 of the FAC.

28 39. Defendant denies the allegations of paragraph 39 of the FAC.

1 40. Defendant denies the allegations of paragraph 40 of the FAC.
 2 41. Defendant denies the allegations of paragraph 41 of the FAC.
 3 42. Defendant denies the allegations of paragraph 42 of the FAC.
 4 43. Defendant admits that Abhyanker, purportedly acting on behalf of Fatdoor,
 5 contacted counsel for Nextdoor on July 8, 2014 and that this communication is reproduced in
 6 Exhibit H to the FAC. Defendant admits that the '328 patent was referenced in this
 7 communication. Defendant denies that this communication was in good faith, as Fatdoor and
 8 Abhyanker are aware that (i) to the extent that any valid patent rights exist, Fatdoor and
 9 Abhyanker have no ownership interest in them; (ii) the patents issued to Abhyanker asserted in
 10 this case were obtained through inequitable conduct by Abhyanker during the prosecution of the
 11 patents, thus rendering them all unenforceable; and (iii) the patents are invalid because the
 12 effective priority dates for the patents are either in 2013 or 2014.

13 44. Defendant admits that in Abhyanker's communication of July 8, 2014, Abhyanker
 14 requested a response by Friday, July 11, 2014 at 1 p.m.

15 45. Defendant admits that counsel to Nextdoor did not respond to Abhyanker's
 16 communication of July 8, 2014 prior to the filing of the FAC. Defendant denies that Nextdoor's
 17 counsel has not otherwise communicated with Abhyanker.

18 46. Defendant denies that the request has gone largely ignored, as Defendant offered
 19 to permit Abhyanker and Fatdoor, subject to certain conditions, to withdraw their claims without
 20 Defendant seeking sanctions or attorneys' fees owed to Defendant for Abhyanker's litigation
 21 misconduct, including bringing unsupported claims in bad faith, tampering of evidence submitted
 22 to the Court and making false statements to the Court. Defendant further denies that Fatdoor
 23 and/or Abhyanker own the patents that Fatdoor purports to offer to license because to the extent
 24 that any valid patent rights exist, Fatdoor and Abhyanker are not entitled to ownership rights in
 25 those patents. Defendant denies the remaining allegations of paragraph 46 of the FAC.

CAUSE OF ACTION (WILLFUL INFRINGEMENT OF '091 PATENT)

26 47. Defendant incorporates and restates its responses to the allegations set forth in
 27 paragraphs 1 through 46 of the FAC.

1 48. Defendant denies the allegations of paragraph 48 of the FAC.
 2 49. Defendant denies the allegations of paragraph 49 of the FAC.
 3 50. Defendant denies the allegations of paragraph 50 of the FAC.
 4 51. Defendant denies the allegations of paragraph 51 of the FAC.
 5 52. Defendant admits that Abhyanker, purportedly acting on behalf of Fatdoor,
 6 contacted counsel for Nextdoor on May 27, 2014 and that this communication is reproduced in
 7 Exhibit G to the FAC. Defendant admits that the '091 patent was referenced in this
 8 communication. Defendant denies that this communication was in good faith, as Fatdoor and
 9 Abhyanker are aware that (i) to the extent that any valid patent rights exist, Fatdoor and
 10 Abhyanker have no ownership interest in them; (ii) the patents issued to Abhyanker asserted in
 11 this case were obtained through inequitable conduct by Abhyanker during the prosecution of the
 12 patents, thus rendering them all unenforceable; and (iii) the patents are invalid because the
 13 effective priority dates for the patents are either in 2013 or 2014.

14 53. Defendant denies the allegations in paragraph 53 of the FAC.
 15 54. Defendant admits that neither executives of Nextdoor nor counsel to Nextdoor
 16 responded to Abhyanker's communication of May 27, 2014 by June 8, 2014.
 17 55. Defendant denies that Plaintiff's requests have gone largely ignored, as Defendant
 18 has offered to permit Abhyanker and Fatdoor, subject to certain conditions, to withdraw their
 19 claims without Defendant seeking sanctions or attorneys' fees owed to Defendant for
 20 Abhyanker's litigation misconduct, including bringing unsupported claims in bad faith, tampering
 21 of evidence submitted to the Court and making false statements to the Court. Defendant further
 22 denies that Fatdoor and/or Abhyanker own the patents that Fatdoor purports to offer to license
 23 because to the extent that any valid patent rights exist, Fatdoor and Abhyanker are not entitled to
 24 ownership rights in those patents. Defendant denies the remaining allegations of paragraph 55 of
 25 the FAC.

CAUSE OF ACTION (WILLFUL INFRINGEMENT OF '545 PATENT)

26 56. Defendant incorporates and restates its responses to the allegations set forth in
 27 paragraphs 1 through 55 of the FAC.

57. Defendant denies the allegations of paragraph 57 of the FAC.

58. Defendant denies the allegations of paragraph 58 of the FAC.

59. Defendant denies the allegations of paragraph 59 of the FAC.

60. Defendant denies the allegations of paragraph 60 of the FAC.

61. Defendant admits that Raj Abhyanker, purportedly acting on behalf of Fatdoor,
acted counsel for Nextdoor on May 27, 2014 and that this communication is reproduced in
part G to the FAC. Defendant admits that the '545 patent was referenced in this
communication. Defendant denies that this communication was in good faith, as Fatdoor and
Abhyanker are aware that (i) to the extent that any valid patent rights exist, Fatdoor and
Abhyanker have no ownership interest in them; (ii) the patents issued to Abhyanker asserted in
these were obtained through inequitable conduct by Abhyanker during the prosecution of the
patents, thus rendering them all unenforceable; and (iii) the patents are invalid because the
asserted priority dates for the patents are either in 2013 or 2014.

62. Defendant denies the allegations in paragraph 62 of the FAC.

15 63. Defendant admits that neither executives of Nextdoor nor counsel to Nextdoor
16 responded to Abhyanker's communication of May 27, 2014 by June 8, 2014.

17 64. Defendant denies that Plaintiff's requests have gone largely ignored, as Defendant
18 has offered to permit Abhyanker and Fatdoor, subject to certain conditions, to withdraw their
19 claims without Defendant seeking sanctions or attorneys' fees owed to Defendant for
20 Abhyanker's litigation misconduct, including bringing unsupported claims in bad faith, tampering
21 of evidence submitted to the Court and making false statements to the Court. Defendant further
22 denies that Fatdoor and/or Abhyanker own the patents that Fatdoor purports to offer to license
23 because to the extent that any valid patent rights exist, Fatdoor and Abhyanker are not entitled to
24 ownership rights in those patents. Defendant denies the remaining allegations of paragraph 64 of
25 the FAC.

REQUEST FOR RELIEF

27 65. Defendant denies that Plaintiff is entitled to any of the relief requested in the FAC.
28 Defendant denies all averments in the FAC that have not been specifically admitted in paragraphs

1 1-64 above.

2 **DEMAND FOR JURY TRIAL**

3 66. Plaintiff's demand for a jury trial does not require a response.

4 **ADDITIONAL DEFENSES**

5 67. Defendant asserts the following additional defenses to the complaint. In doing so,
 6 Defendant does not assume any burden of proof on any issue that is Plaintiff's burden as a matter
 7 of law. Defendant also reserves the right to amend or supplement these defenses as additional
 8 facts become known.

9 **FIRST DEFENSE: FAILURE TO STATE A CAUSE OF ACTION**

10 68. The complaint fails to state a cause of action against Defendant for which relief
 11 can be granted.

12 **SECOND DEFENSE: NON-INFRINGEMENT ('328 PATENT)**

13 69. Defendant has not infringed, and currently does not infringe, any valid claim of the
 14 '328 patent and is not liable for any infringement.

15 **THIRD DEFENSE: INVALIDITY ('328 PATENT)**

16 70. The '328 patent is invalid for failure to meet one or more of the conditions for
 17 patentability specified in Title 35, U.S.C., or the rules, regulations, and law related thereto,
 18 including, without limitation, one or more of 35 U.S.C. §§ 101, 102, 103, and/or 112.

19 **FOURTH DEFENSE: NON-INFRINGEMENT ('091 PATENT)**

20 71. Defendant has not infringed, and currently does not infringe, any valid claim of the
 21 '091 patent and is not liable for any infringement.

22 **FIFTH DEFENSE: INVALIDITY ('091 PATENT)**

23 72. The '091 patent is invalid for failure to meet one or more of the conditions for
 24 patentability specified in Title 35, U.S.C., or the rules, regulations, and law related thereto,
 25 including, without limitation, one or more of 35 U.S.C. §§ 101, 102, 103, and/or 112.

26 **SIXTH DEFENSE: NON-INFRINGEMENT ('545 PATENT)**

27 73. Defendant has not infringed, and currently does not infringe, any valid claim of the
 28 '545 patent and is not liable for any infringement.

SEVENTH DEFENSE: INVALIDITY ('545 PATENT)

74. The '545 patent is invalid for failure to meet one or more of the conditions for patentability specified in Title 35, U.S.C., or the rules, regulations, and law related thereto, including, without limitation, one or more of 35 U.S.C. §§ 101, 102, 103, and/or 112.

EIGHTH DEFENSE: ESTOPPEL

75. The relief sought by Plaintiff is barred, in whole or in part, under the doctrine of prosecution history estoppel due to Plaintiff's (or Plaintiff's predecessor-in-interest's) prior conduct, including the amendment, cancellation, or abandonment of claims before the United States Patent and Trademark Office and/or admissions or other statements made to the United States Patent and Trademark Office during prosecution of the '328 patent, the '091 patent, the '545 patent, or related patent applications.

NINTH DEFENSE: DEDICATION TO THE PUBLIC

76. The relief sought by Plaintiff is barred, in whole or in part, because Plaintiff dedicated to the public all methods, systems, and products disclosed in the '328 patent, the '091 patent, and/or the '545 patent but not literally claimed therein.

TENTH DEFENSE: LACK OF STANDING

77. Plaintiff lacks standing to assert infringement of the '328 patent, the '091 patent, and/or the '545 patent because it did not have sufficient rights in the '328 patent, the '091 patent, and/or the '545 patent at the time the suit was filed.

ELEVENTH DEFENSE: LACK OF OWNERSHIP

78. Plaintiff is barred from obtaining all, or part of, the relief it seeks because it lacks sufficient ownership interests in the '328 patent, the '091 patent, and/or the '545 patent to pursue claims of infringement against Defendant.

TWELFTH DEFENSE: UNAVAILABILITY OF INJUNCTIVE RELIEF

79. Plaintiff is not entitled to injunctive relief, as a matter of law, and cannot satisfy the requirements applicable to its request for injunctive relief in any form.

THIRTEENTH DEFENSE: INEQUITABLE CONDUCT ('091 PATENT)

Introduction

80. The '091 patent, and each claim thereof, is unenforceable due to inequitable conduct during its prosecution.

81. During prosecution of the '091 patent, Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized information that he knew would have been important to a reasonable examiner in determining whether to issue the patent.

82. Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized this material information with a specific intent to deceive the United States Patent and Trademark Office (“USPTO”).

83. Abhyanker filed U.S. Patent Application No. 14/151,844 (the “’844 application”) on January 10, 2014. The ’844 application issued as the ’091 patent.

84. Abhyanker, the named inventor of the '844 application, served as patent prosecution counsel for the '844 application.

85. Abhyanker's USPTO registration number, submitted with his filings in the '844 application, is Reg. No. 45474.

Improper Claims of Priority

86. Upon information and belief, Abhyanker, as a licensed patent attorney, is familiar with the rules governing the patent process.

87. Specifically, upon information and belief, Abhyanker knew at the time he filed the '844 application that in order to claim the benefit of an earlier application's priority date, 1) the invention disclosed in the earlier application must support the claims of the later application, and 2) the two applications must have been co-pending.

88. The USPTO issued and mailed a non-final rejection on March 17, 2014, rejecting all pending claims of the '844 application in light of Kaplan, Dan, "Fatdoor turns neighborhoods into online social networks," May 28, 2007 ("Kaplan").

89. Kaplan described the public use and sale of Fatdoor services offered by a previous company called Fatdoor, Inc. (“Fatdoor I”) which Raj Abhyanker, the CEO of the later entity,

1 Plaintiff Fatdoor, Inc. also served as CEO.

2 90. Upon information and belief, Abhyanker and therefore Plaintiff Fatdoor, Inc. knew
 3 that Fatdoor I offered services similar to those claimed in the pending claims of the '844
 4 application.

5 91. The USPTO rejected independent claim 1 of the '844 application as anticipated by
 6 Kaplan because it "discloses a neighborhood communication system: a privacy server: to verify
 7 that each user of the community network lives at a residence associated with a claimable
 8 residential address of the community network formed through a social community module of a
 9 privacy server using a processor and a memory; to obtain from each user of the community
 10 network, using the processor of a computing device, member data associated with each user, the
 11 member data including an address; to associate the address with a profile of each user; to
 12 determine a location of each user based on the member data; to store the member data in a
 13 database; and to obtain a personal address privacy preference from each user, the personal address
 14 privacy preference specifying if the address should be displayed to other users; and a mapping
 15 server associated with the privacy server through a network to generate a geospatial
 16 representation of a set of points on a map defining residences associated with each use of the
 17 community network having the member data."

18 92. The USPTO rejected independent claim 13 of the '844 application as anticipated
 19 by Kaplan because it "discloses [a] method of organizing a community network, comprising:
 20 verifying that each user of the community network lives at a residence associated with a
 21 claimable residential address of the community network formed through a social community
 22 module of a privacy server using a processor and a memory; obtaining from each user of the
 23 community network, using the processor of a computing device, member data associated with
 24 each user, the member data including an address; associating the address with a profile of each
 25 user; determining a location of each user based on the member data; storing the member data in a
 26 database; and obtaining a personal address privacy preference from each user, the personal
 27 address privacy preference specifying if the address should be displayed to other users."

28 93. The USPTO rejected independent claim 25 of the '844 application as anticipated

1 by Kaplan because it “discloses a neighborhood communication system comprising: a privacy
 2 server; to verify that each user of the community network lives at a residence associated with a
 3 claimable residential address of the community network formed through a social community
 4 module of a privacy server using a processor and a memory; to obtain from each user of the
 5 community network, using the processor of a computing device, member data associated with
 6 each user, the member data including an address; to associate the address with a profile of each
 7 user; to determine a location of each user based on the member data; to store the member data in a
 8 database; and to obtain a personal address privacy preference from each user, the personal address
 9 privacy preference specifying if the address should be displayed to other users; a network; and a
 10 mapping server associated with the privacy server through a network: to generate a geospatial
 11 representation of a set of points on a map defining residences associated with each use of the
 12 community network having the member data, determine that a marker is colliding with another
 13 marker simultaneously displayed in a map based on an overlap area of the marker with the
 14 another marker, automatically create a group pointer that replaces the marker and the another
 15 marker on the map, generate a view of the marker and the another marker when a user selects the
 16 group pointer, and determine that the marker, the another marker, and different markers are
 17 associated with a shared structure based on address data associated with occupants represented
 18 through the marker, the another marker and the different markers.”

19 94. Abhyanker submitted a Response to Non-Final Office Action on March 26, 2014
 20 (the “Response”).

21 95. In the Response, Abhyanker contested the USPTO’s determination that Kaplan
 22 anticipated the pending claims of the ’844 application.

23 96. Abhyanker represented to the USPTO that Kaplan was disqualified as prior art on
 24 the ground that the ’844 application was entitled to a priority date of March 17, 2006.

25 97. Abhyanker represented to the USPTO that the pending claims of the ’844
 26 application were entitled to claim priority to U.S. Patent Application 11/653,194 (the “’194
 27 application”), filed on January 12, 2007, which in turn claimed priority to U.S. Patent
 28 Application No. 11/603,442 (the “’442 application”), filed on November 22, 2006.

1 98. The '442 application claims priority to U.S. Provisional Application 60/783,226,
 2 filed on March 17, 2006.

3 99. Abhyanker's claims for priority in the '844 application to the '442 and '194
 4 applications are improper. For example, a pending claim is entitled to the benefit of the filing
 5 date of an earlier-filed application only if that earlier-filed application discloses each and every
 6 element of the pending claim.

7 100. As such, by representing to the USPTO that the pending claims of the '844
 8 application were entitled to the filing dates of the '194 and '442 applications, Abhyanker in effect
 9 represented that the specifications of the '194 and '442 applications each fully disclosed the
 10 subject matter of the pending claims of the '844 application.

11 101. This representation by Abhyanker to the USPTO as to the '194 application was
 12 incorrect. None of the pending '844 claims was supported by the '194 application.

13 102. By way of example, the concept of a "privacy preference," a central feature of all
 14 claims of the '844 application, is found nowhere in the disclosures of the '194 application.

15 103. Similarly, Abhyanker's representation to the USPTO as to the '442 application
 16 was incorrect. None of the pending claims in the '844 application was supported by the '442
 17 application

18 104. By way of example, the concept of a "privacy preference," a central feature of all
 19 claims of the '844 application, is found nowhere in the disclosures of the '442 application.

20 105. On information and belief, Abhyanker intentionally made these representations,
 21 knowing them to be incorrect, in order to mislead the USPTO as to the content of the '442 and
 22 '194 applications.

23 106. Abhyanker is the sole inventor listed on the '442 and '194 applications, filed in
 24 2006 and 2007 respectively. Abhyanker thus is familiar with the subject matter disclosed in those
 25 applications.

26 107. Given his status the sole inventor of the '442 and '194 applications, Abhyanker
 27 knew that those applications did not fully support the pending claims of the '844 application,
 28 including without limitation that those applications did not disclose a "privacy preference."

1 108. Additionally, the '844 application fails to meet the co-pendency requirement at
 2 least with respect to the '442 application. The '442 application was abandoned on June 24, 2009.
 3 Abhyanker later filed the '844 application on January 10, 2014, identifying the '844 application
 4 as a continuation-in-part of the '442 application.

5 109. Thus, the '844 application and '442 application were not co-pending.

6 110. Upon information and belief, Abhyanker recognized after he filed the '844
 7 application that co-pendency was lacking.

8 111. On January 21, 2014—over four years after the '442 application was abandoned
 9 and eleven days after filing the '844 application—Abhyanker filed a request for continued
 10 examination of the '442 application in a sham effort to establish co-pendency.

11 112. However, because the '442 application was abandoned at the time Abhyanker filed
 12 the '844 application, the '844 application was not co-pending with the '442 application.

13 113. Upon information and belief, Abhyanker knew that the '442 application and '194
 14 application disclosures did not support any of the pending claims of the '844 application and that
 15 co-pendency was lacking at least between the '091 patent application and the '442 application.

16 114. Abhyanker's misrepresentations concerning the co-pendency of the '442
 17 application and the entitlement of the '844 application to the priority dates of the '194 and '442
 18 applications were material, as evidenced at least by the USPTO's rejection of the pending claims
 19 of the '844 application in light of Kaplan and the USPTO's withdrawal its rejection in response to
 20 Abhyanker's misrepresentations concerning the '194 and '442 applications.

21 115. Absent these misrepresentations, the USPTO would not have disqualified Kaplan
 22 as prior art.

23 116. Moreover, upon information and belief, Abhyanker knew that his improper claims
 24 of priority to the '442 and '194 applications were material to the patentability of the pending
 25 claims of the '844 application.

26 117. Abhyanker exhibited as much during the prosecution of the '844 application. As
 27 noted above, in his Response, Abhyanker argued that Kaplan should be disqualified because the
 28 pending claims of the '844 application were entitled to claim the benefit of the '194 and '442

1 applications.

2 118. Upon further information and belief, Abhyanker had the specific intent of claiming
 3 priority to the '442 and '194 applications in an attempt to deceive the USPTO and avoid prior art,
 4 such as the public use of the Fatdoor services by Fatdoor I, that a reasonable examiner would rely
 5 upon to reject the pending claims of the '844 application. Those claims, now issued as the '091
 6 patent, would stand rejected but for Abhyanker's improper claims of priority to the '194 and '442
 7 applications.

8 119. Abhyanker's claims of priority in the '844 application misrepresented information
 9 material to patentability.

10 120. Upon information and belief, Abhyanker specifically intended to deceive the
 11 USPTO as to whether the pending claims of the '844 application were entitled to the priority date
 12 of either the '194 application or '442 application.

Misrepresentation Regarding AIA Rules

13 121. In addition to his material misrepresentation of the '091 patent's priority date,
 14 Abhyanker omitted material information when, during the '844 application's prosecution, he did
 15 not indicate to the USPTO that the '091 patent application should be examined under the first-to-
 16 file provisions of the America Invents Act ("AIA") because it has at least one claim with an
 17 effective filing date after March 16, 2013.
 18

19 122. Upon information and belief, Abhyanker, a licensed patent attorney, knew that the
 20 '844 application, a continuation-in-part filed in 2014, had at least one claim with an effective date
 21 after March 16, 2013.

22 123. Nevertheless, Abhyanker did not check the box provided on a USPTO form to
 23 indicate that the '844 application should be examined under AIA rules, upon information and
 24 belief, with the specific intent of deceiving the USPTO and avoiding prior art, such as the public
 25 use of Fatdoor services.

26 124. Had Abhyanker properly indicated that the '844 application should be examined
 27 according to the AIA, one or more claims would have been accorded the January 10, 2014 '844
 28 application filing date, and the USPTO would have rejected those claims in view of Kaplan.

1 125. Abhyanker's contention that the '844 application should be examined according to
 2 pre-AIA rules misrepresented information material to patentability.

3 126. Upon information and belief, Abhyanker specifically intended to deceive the
 4 USPTO as to whether the pending claims of the '844 application were entitled to be examined
 5 under pre-AIA rules.

6 **Failure to Disclose References Relied on by the USPTO During Prosecution of Another**
 7 **Patent Application**

8 127. During prosecution of the '844 application, Abhyanker contended that the '844
 9 application was entitled to the benefit of the '194 application's priority date.

10 128. This contention was an effort to support his improper priority claims.

11 129. Accordingly, and by Abhyanker's own representation, the '194 application
 12 discloses similar subject matter to that claimed by the '844 application.

13 130. Abhyanker did not disclose the following references to the USPTO during the
 14 prosecution of the '844 application: Publication No. US-2001/0005829 by Raveis ("Raveis");
 15 Publication No. US-2006/0022048 by Johnson ("Johnson"); and Publication No. US-
 16 2007/1056429 by Godar ("Godar").

17 131. The USPTO cited Raevis in support of a non-final rejection of the '194 application
 18 issued on May 10, 2011.

19 132. The USPTO cited Johnson in support of a final rejection of the '194 application
 20 issued on December 10, 2012.

21 133. The USPTO cited Godar in support of a non-final rejection of the '194 application
 22 issued on January 28, 2014.

23 134. That the USPTO cited these references in support of its rejection of the '194
 24 application, particularly in view of Abhyanker's argument of this application's relevance to the
 25 '844 application's claims, confirms that the USPTO would have considered them prior art
 26 material to the patentability of the '844 application.

27 135. Upon information and belief, and in view of Abhyanker's knowledge that his
 28 claims of priority were improper (as well his contemporaneous knowledge of the USPTO's

1 rejection of such a priority date in connection with the '612 application that led to the '545 patent,
 2 as explained below), Abhyanker knew that the USPTO would have considered these references to
 3 be prior art material to the patentability of the '844 application.

4 136. Abhyanker nonetheless did not disclose Raevis, Johnson, or Godar during
 5 prosecution of the '844 application even though he knew that the USPTO would have considered
 6 them to be prior art material to patentability.

7 137. Upon information and belief, Abhyanker specifically intended to deceive the
 8 USPTO as to the existence of material prior art such as Raevis, Johnson, and Godar.

9 **Failure to Disclose References Identified by the USPTO During Prosecution of Another**
 10 **Patent Application**

11 138. Abhyanker also did not disclose the following references to the USPTO during the
 12 prosecution of the '844 application: Publication No. US-2004/0039581 by Wheeler ("Wheeler");
 13 Publication No. US-2006/0190279 by Heflin ("Heflin"); Publication No. US-2003/022807 by
 14 Hoffman ("Hoffman"); and Publication No. US-2005/0203768 by Florance ("Florance").

15 139. In a non-final rejection of the '194 application issued on January 28, 2014, the
 16 USPTO notified Abhyanker that it considered all of these references relevant to the '194
 17 application even though it had not specifically outlined their application under 35 U.S.C. §§ 102
 18 or 103. The USPTO advised Abhyanker to review these references in particular.

19 140. That the USPTO identified these references as relevant in support of its rejection
 20 of the '194 application, particularly in view of Abhyanker's arguments that the '194 application
 21 fully discloses the invention(s) claimed in the '844 application, confirms that the USPTO would
 22 have considered it to be prior art material to the patentability of the '844 application.

23 141. Upon information and belief, and in view of Abhyanker's knowledge that his
 24 claims of priority were improper (as well his contemporaneous knowledge of the USPTO's
 25 rejection of such a priority date in connection with the '612 application that led to the '545 patent,
 26 as explained below), Abhyanker knew that the USPTO would have considered these references to
 27 be prior art material to the patentability of the '844 application.

28 142. Abhyanker nonetheless did not disclose Wheeler, Heflin, Hoffman, or Florance

during prosecution of the '844 application even though he knew that the USPTO would have considered them to be prior art material to patentability.

143. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as Wheeler, Heflin, Hoffman, and Florence.

Failure to Disclose Nextdoor.com Website

144. Abhyanker also did not disclose the existence of Defendant's website, Nextdoor.com, and services and features provided therein, in an information disclosure statement during prosecution of the '844 application.

145. Nextdoor.com launched to the general public in October 2011, although it had been in public beta testing since early 2011.

146. Given that Abhyanker has, on the day of issuance, accused the Nextdoor.com website of infringing the '091 patent, Abhyanker knew that the USPTO would have considered the Nextdoor.com website material to patentability.

147. Upon information and belief, and in view of Abhyanker's knowledge that his claims of priority were improper, as well his contemporaneous knowledge of the USPTO's rejection of such a priority date in connection with the '612 application that led to the '545 patent, as explained below, Abhyanker knew that the USPTO would have considered Nextdoor.com to be prior art material to the patentability of the '844 application.

148. Abhyanker nonetheless did not disclose the Nextdoor.com website during prosecution of the '844 application even though he knew that the USPTO would have considered it to be prior art material to patentability.

149. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as the Nextdoor.com website.

Conclusion

150. In sum, on information and belief, Abhyanker, the inventor and patent attorney for the '091 patent, misrepresented and omitted material information with the intent to deceive the USPTO to ensure the issuance of the '091 patent.

151. By reason of this inequitable conduct, the '091 patent and all related patents are

1 unenforceable.

2 152. The '091 patent is further unenforceable as a result of Abhyanker's inequitable
 3 conduct committed during the prosecution of related patent applications, including without
 4 limitation U.S. Patent Application No. 14/203,531, addressed below, and U.S. Patent Application
 5 No. 14/144,612, addressed below.

6 **FOURTEENTH DEFENSE: INEQUITABLE CONDUCT ('545 PATENT)**

7 **Introduction**

8 153. The '545 patent, and each claim thereof, is unenforceable due to inequitable
 9 conduct during its prosecution.

10 154. During prosecution of the '545 patent, Abhyanker failed to disclose, withheld,
 11 concealed, and/or mischaracterized information that he knew would have been important to a
 12 reasonable examiner in determining whether to issue the patent.

13 155. Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized this
 14 material information with a specific intent to deceive the United States Patent and Trademark
 15 Office ("USPTO").

16 156. Abhyanker filed U.S. Patent Application No. 14/144,612 (the "'612 application")
 17 on December 31, 2013. The '612 application issued as the '545 patent.

18 157. Abhyanker, the named inventor of the '612 application, served as patent
 19 prosecution counsel for the '612 application.

20 158. Abhyanker's USPTO registration number, submitted with his filings in the '612
 21 application, is Reg. No. 45474.

22 **Improper Claims of Priority**

23 159. Upon information and belief, Abhyanker, as a licensed patent attorney, is familiar
 24 with the rules governing the patent process.

25 160. Specifically, upon information and belief, Abhyanker knew at the time he filed the
 26 '612 application that in order to claim the benefit of an earlier application's priority date, 1) the
 27 invention disclosed in the earlier application must support the claims of the later application, and
 28 2) the two applications must have been co-pending.

1 161. The USPTO issued and mailed a non-final rejection on March 6, 2014, rejecting
 2 all pending claims of the '612 application.

3 162. The USPTO's rejection stood in part on the ground that Abhyanker's priority
 4 claims were improper and that, instead, the claims of the '612 application were entitled to an
 5 effective filing date of December 31, 2013.

6 163. The USPTO further based its rejection under 35 U.S.C. 103(a), finding that the
 7 claims of the '612 application were unpatentable over Abhyanker's own '442 application and
 8 U.S. Patent Application No. 11/717,807 (the "'087 application), filed in 2006 and 2007,
 9 respectively.

10 164. Abhyanker submitted a response to the non-final office action on March 10, 2014
 11 (the "'612 Response").

12 165. In the '612 Response, Abhyanker contested the USPTO's determination that the
 13 claims of the '612 application were entitled to an effective filing date of December 31, 2013.

14 166. Abhyanker represented to the USPTO that the pending claims of the '612
 15 application were entitled to claim priority to the '194 application, filed on January 12, 2007,
 16 which in turn claimed priority to the '442, filed on November 22, 2006.

17 167. The '442 application claims priority to U.S. Provisional Application 60/783,226,
 18 filed on March 17, 2006.

19 168. Abhyanker's claims for priority in the '844 application to the '442 and '194
 20 applications are improper. For example, a pending claim is entitled to the benefit of the filing
 21 date of an earlier-filed application only if that earlier-filed application discloses each and every
 22 element of the pending claim.

23 169. In the Response, Abhyanker specifically represented that the pending claims of the
 24 '612 application were "entirely supported" in the specification of the '194 application, as well as
 25 by the specifications of two other patent applications, Nos. 11/731,465 (the "'465 application")
 26 and 11/827,400 (the "'400 application").

27 170. This representation by Abhyanker to the USPTO as to the '194, '465, and '400
 28 applications was incorrect. None of the pending claims of the '612 application was supported by

1 these applications.

2 171. By way of example, the concept of conducting “high value crime and safety
 3 related discussions,” which is central to all claims of the ’612 application, is found nowhere in the
 4 disclosures of the ’194, ’465, or ’400 applications.

5 172. On information and belief, Abhyanker, a licensed patent attorney, intentionally
 6 made these representations, knowing them to be incorrect, in order to mislead the USPTO as to
 7 the content of the ’194, ’465, and ’400 applications.

8 173. Abhyanker is the sole inventor listed on the ’194, ’465, and ’400 applications, all
 9 filed in 2007. Abhyanker thus is familiar with the subject matter disclosed in those applications.

10 174. Given his status as the sole inventor of the ’194, ’465, and ’400 applications,
 11 Abhyanker knew that those applications did not fully support the pending claims of the ’612
 12 application, including without limitation that those applications did not disclose the concept of
 13 conducting “high value crime and safety related discussions.”

14 175. Additionally, the ’612 application fails to meet the co-pendency requirement at
 15 least with respect to the ’442 application. The ’442 application was abandoned on June 24, 2009.
 16 Abhyanker later filed the ’612 application on December 31, 2013.

17 176. Thus, the ’612 application and ’442 application were not co-pending.

18 177. Upon information and belief, Abhyanker recognized after he filed the ’612
 19 application that co-pendency was lacking.

20 178. On January 21, 2014—over four years after the ’442 application was abandoned
 21 and twenty-one days after filing the ’612 application—Abhyanker filed a request for continued
 22 examination of the ’442 application in a sham effort to establish co-pendency.

23 179. However, because the ’442 application was abandoned at the time Abhyanker filed
 24 the ’612 application, the ’612 application was not co-pending with the ’442 application.

25 180. Upon information and belief, Abhyanker knew that the ’442 application and ’194
 26 application disclosures did not support any of the pending claims of the ’612 application and that
 27 co-pendency was lacking at least between the ’612 patent application and the ’442 application.

28 181. Abhyanker nonetheless represented in the Response of March 10, 2014 that the

'612 application was entitled to the benefit of the '442 application's priority date.

Failure to Disclose Kaplan Reference Relyed on by the USPTO or Other Fatdoor References During the Prosecution of Another Application

182. Abhyanker also did not disclose the following reference to the USPTO during the prosecution of the '612 application: Kaplan, Dan, "Fatdoor turns neighborhoods into online social networks," May 28, 2007 ("Kaplan").

183. Kaplan describes the public use and sale of Fatdoor services offered by a previous company called Fatdoor, Inc. (“Fatdoor I”) of which Raj Abhyanker, the CEO of the later entity, Plaintiff Fatdoor, Inc. also served as CEO.

184. More generally, Abhyanker failed to disclose any references describing services offered by Fatdoor I, including the fatdoor.com website.

185. Upon information and belief, Abhyanker knew that Fatdoor I offered services similar to those claimed in the pending claims of the '612 application.

186. Abhyanker became aware of Kaplan in particular no later than March 17, 2014, at which time Kaplan was cited by the USPTO during prosecution of the '844 application in connection with a non-final rejection.

¹⁸⁷ Abhyanker did not disclose the office action wherein the examiner cited Kaplan.

188. Abhyanker was personally involved in the development of Fatdoor I and was aware of services made publicly available at fatdoor.com.

189. The '091 and '545 patents disclose and claim similar subject matter, and the '091 patent claims to be a continuation-in-part of the '612 application.

190. Accordingly, material prior art to the '844 application would also have been material prior art to the '612 application.

191. Upon information and belief, Abhyanker knew that the USPTO would have found Kaplan to be material to patentability because the USPTO had previously relied on Kaplan in issuing a rejection of the '844 application.

192. During the prosecution of the '844 application, Abhyanker argued that Kaplan was not prior art to the '844 application because the '844 application was entitled to a priority date

prior to Kaplan's publication date of May 28, 2007, in particular, that of the '442 application, filed November 22, 2006.

193. During the prosecution of the '612 application, Abhyanker argued that the '612 patent was also entitled to the '442 application's priority date.

194. The USPTO rejected Abhyanker's claim of priority for the '612 application, instead according its claims an effective filing date of December 31, 2013. The USPTO accordingly examined the '612 application under AIA rules.

195. Upon information and belief, Abhyanker knew that the USPTO would have considered Kaplan to be prior art to the '612 application.

196. Abhyanker nonetheless did not disclose Kaplan during prosecution of the '612 application even though he knew that the USPTO would have considered Kaplan to be prior art material to patentability.

197. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as Kaplan.

198. Upon information and belief, because Kaplan describes the operation of services then available at fatdoor.com, Abhyanker knew that the USPTO would have considered fatdoor.com, or any reference describing it, to be prior art to the '612 application.

199. Abhyanker nonetheless did not disclose fatdoor.com, or any reference describing it, during prosecution of the '612 application even though he knew that the USPTO would have considered them to be prior art material to patentability.

200. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as fatdoor.com or any reference describing it.

Failure to Disclose Other References Relied on by the USPTO During the Prosecution of the '844 Application

201. The USPTO cited several other references in support of the non-final rejection of the '844 application on March 17, 2014. These include U.S. Patent No. 8,650,103, by Wilf et al. ("Wilf"); Publication No. US-2013/0282842, by Blecon et al. ("Blecon"); Publication No. US-

1 2011/0231268, by Ungos (“Ungos”); and an article from Wired.com entitled “Fatdoor CEO Talks
 2 about balancing security with community,” by Russell (“Russell”).

3 202. That the USPTO cited these references in support of its rejection of the ’844
 4 application confirms that the USPTO would have considered them prior art material to the
 5 patentability of the ’612 application.

6 203. Upon information and belief, and in view of the USPTO’s conclusion that the ’612
 7 application’s claims were entitled to an effective filing date of December 31, 2013, Abhyanker
 8 knew that the USPTO would have considered these references to be prior art material to the
 9 patentability of the ’612 application.

10 204. Abhyanker nonetheless did not disclose Wilf, Blecon, Ungos, or Russell during
 11 prosecution of the ’612 application even though he knew that the USPTO would have considered
 12 them to be prior art material to patentability.

13 205. Upon information and belief, Abhyanker specifically intended to deceive the
 14 USPTO as to the existence of material prior art such as Wilf, Blecon, Ungos, and Russell.

15 **Failure to Disclose References Relied on by the USPTO During the**
Prosecution of the ’194 and ’400 Applications

16 206. In addition, during prosecution of the ’612 application, Abhyanker argued, in a
 17 March 10, 2014 response to a March 6, 2014 non-final rejection, that the independent claims of
 18 the ’612 application “are entirely supported” in the specifications of the ’194, ’465, and ’400
 19 applications.

20 207. Accordingly, and by Abhyanker’s own representation, the ’194, ’465, and ’400
 21 applications disclose similar subject matter to that claimed by the ’612 application.

22 208. Abhyanker did not disclose the following references to the USPTO during the
 23 prosecution of the ’612 application: Publication No. US-2001/0005829 by Raveis (“Raveis”);
 24 Publication No. US-2006/0022048 by Johnson (“Johnson”); Publication No. US-2007/1056429
 25 by Godar (“Godar”); Publication No. 2008/0125969 by Chen (“Chen”); and Publication No.
 26 2007/0203644 by Thota (“Thota”).

27 209. The USPTO cited Raevis in support of a non-final rejection of the ’194 application

1 issued on May 10, 2011.

2 210. The USPTO cited Johnson in support of a final rejection of the '194 application
3 issued on December 10, 2012.

4 211. The USPTO cited Godar in support of a non-final rejection of the '194 application
5 issued on January 28, 2014.

6 212. The USPTO cited Chen and Thota in support of a non-final rejection of the '400
7 application issued on April 12, 2011.

8 213. That the USPTO cited these references in support of its rejection of the '194 and
9 '400 applications, particularly in view of Abhyanker's argument of these applications' relevance
10 to the '612 application's claims, confirms that the USPTO would have considered them prior art
11 material to the patentability of the '612 application.

12 214. Upon information and belief, and in view of the USPTO's conclusion that the '612
13 application's claims were entitled to an effective filing date of December 31, 2013, Abhyanker
14 knew that the USPTO would have considered these references to be prior art material to the
15 patentability of the '612 application.

16 215. Abhyanker nonetheless did not disclose Raevis, Johnson, Godar, Chen, and Thota
17 during prosecution of the '612 application even though he knew that the USPTO would have
18 considered them to be prior art material to patentability.

19 216. Upon information and belief, Abhyanker specifically intended to deceive the
20 USPTO as to the existence of material prior art such as Raevis, Johnson, Godar, Chen, and Thota.

21 **Failure to Disclose References Identified by the USPTO**
22 **During the Prosecution of the '194 Application**

23 217. Abhyanker also did not disclose the following references to the USPTO during the
24 prosecution of the '612 application: Publication No. US-2004/0039581 by Wheeler ("Wheeler");
25 Publication No. US-2006/0190279 by Heflin ("Heflin"); Publication No. US-2003/022807 by
26 Hoffman ("Hoffman"); and Publication No. US-2005/0203768 by Florance ("Florance").

27 218. In a non-final rejection of the '194 application issued on January 28, 2014, the
28 USPTO notified Abhyanker that it considered all of these references relevant to the '194

1 application even though it had not specifically outlined their application under 35 U.S.C. §§ 102
 2 or 103. The USPTO advised Abhyanker to review these references in particular.

3 219. That the USPTO identified these references as relevant in support of its rejection
 4 of the '194 application, particularly in view of Abhyanker's argument of this application's
 5 relevance to the '612 application's claims, confirms that the USPTO would have considered it to
 6 be prior art material to the patentability of the '612 application.

7 220. Upon information and belief, and in view of the USPTO's conclusion that the '612
 8 application's claims were entitled to an effective filing date of December 31, 2013, Abhyanker
 9 knew that the USPTO would have considered these references to be prior art material to the
 10 patentability of the '612 application.

11 221. Abhyanker nonetheless did not disclose Wheeler, Heflin, Hoffman, and Florance
 12 during prosecution of the '612 application even though he knew that the USPTO would have
 13 considered them to be prior art material to patentability.

14 222. Upon information and belief, Abhyanker specifically intended to deceive the
 15 USPTO as to the existence of material prior art such as Wheeler, Heflin, Hoffman, and Florance.

Failure to Disclose the Nextdoor.com Website

17 223. Abhyanker also did not disclose the existence of Defendant's website,
 18 Nextdoor.com, and services and features provided therein, in an information disclosure statement
 19 during prosecution of the '612 application.

20 224. Nextdoor.com launched to the general public in October 2011, although it had
 21 been in public beta testing since early 2011.

22 225. Given that Abhyanker has accused the Nextdoor.com website of infringing the
 23 '545 patent, Abhyanker knew that the USPTO would have considered the Nextdoor.com website
 24 material to patentability.

25 226. Given that the USPTO accorded the '612 application's claims an effective filing
 26 date of December 31, 2013, Abhyanker knew that the USPTO would have considered
 27 Nextdoor.com to be prior art to the '612 application.

28 227. Abhyanker nonetheless did not disclose the Nextdoor.com website during

prosecution of the '612 application even though he knew that the USPTO would have considered it to be prior art material to patentability.

228. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as the Nextdoor.com website.

Conclusion

229. In sum, on information and belief, Raj Abhyanker, the inventor and patent attorney for the '545 patent, misrepresented and omitted material information with the intent to deceive the USPTO to ensure the issuance of the '545 patent.

230. By reason of this inequitable conduct, the '545 patent and all related patents are unenforceable.

231. The '545 patent is further unenforceable as a result of Abhyanker's inequitable conduct committed during the prosecution of related patent applications, including without limitation U.S. Patent Application Nos. 14/203,531, addressed below, and 14/151,844, addressed above.

FIFTEENTH DEFENSE: INEQUITABLE CONDUCT ('328 PATENT)

Introduction

232. The '328 patent, and each claim thereof, is unenforceable due to inequitable conduct during its prosecution.

233. During prosecution of the '328 patent, Raj Abhyanker ("Abhyanker") failed to disclose, withheld, concealed, and/or mischaracterized information that he knew would have been important to a reasonable examiner in determining whether to issue the patent.

234. Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized this material information with a specific intent to deceive the United States Patent and Trademark Office (“USPTO”).

235. Abhyanker filed U.S. Patent Application No. 14/203,531 (the “’531 application”) on March 10, 2014. The ’531 application issued as the ’328 patent.

236. Abhyanker, the named inventor of the '531 application, served as patent prosecution counsel for the '531 application.

237. Abhyanker's USPTO registration number, submitted with his filings in the '531 application, is Reg. No. 45474.

Improper Claims of Priority

238. Upon information and belief, Abhyanker, as a licensed patent attorney, is familiar with the rules governing the patent process.

239. Specifically, upon information and belief, Abhyanker knew at the time he filed the '531 application that in order to claim the benefit of an earlier application's priority date, 1) the invention disclosed in the earlier application must support the claims of the later application, and 2) the two applications must have been co-pending.

240. Abhyanker represented to the USPTO that the pending claims of the '531 application were entitled to claim priority to U.S. Patent Application 11/653,194 (the "'194 application"), filed on January 12, 2007, which in turn claimed priority to U.S. Patent Application No. 11/603,442 (the "'442 application"), filed on November 22, 2006.

241. Abhyanker further represented that the '442 and '194 applications disclosed each and every element of the pending claims of the '531 application by submitting a claim chart to that effect to the USPTO.

242. Additionally, the '531 application fails to meet the co-pendency requirement at least with respect to the '442 application because the '442 application was abandoned at the time Abhyanker filed the '531 application.

243. Upon information and belief, Abhyanker recognized that the '531 and '442 applications were not co-pending.

244. For this reason, Abhyanker sought to claim the benefit of the '442 application's priority date by claiming priority to the '194 application.

245. However, the '194 application's disclosure did not support the pending claims of the '531 application.

246. Upon information and belief, Abhyanker recognized that the '194 application's disclosure did not support the pending claims of the '531 application.

247 Therefore, in a preliminary amendment dated May 12, 2014, Abbvianker inserted

matter into the specification of the '531 application that is not found in the '194 application's disclosure.

248. In the May 12, 2014 preliminary amendment, Abhyanker asserted that no new matter had been added, but instead that such matter was incorporated from the '442 application.

249. This statement in the May 12, 2014 preliminary amendment is untrue. The '531 application adds new matter to the '194 application's disclosure.

250. Abhyanker's misrepresentations concerning the entitlement of the '531 application to the priority dates of the '194 and '442 applications were material to patentability because the examiner would have accorded the '531 application an effective filing date of no earlier than March 10, 2014 absent these misrepresentations.

251. The examiner would have then considered numerous other references to be prior art to the '531 application, including, without limitation, references describing the public use and sale of Fatdoor services offered by a previous company called Fatdoor, Inc. ("Fatdoor I") of which Raj Abhyanker, the CEO of the later entity, Plaintiff Fatdoor, Inc., also served as CEO. One such reference is Kaplan, Dan, "Fatdoor turns neighborhoods into online social networks," May 28, 2007 ("Kaplan"), which was cited in a non-final rejection of the '844 application (which issued as the '091 patent) on March 17, 2014.

252. That the USPTO cited Kaplan in a rejection of the '091 patent, which discloses and claims similar subject matter as the '531 application and which claims priority to the same '194 application, confirms that the USPTO would have considered Kaplan to be a material prior art reference if it considered Kaplan to be prior art.

253. Thus, Abhyanker's claims of priority in the '531 application misrepresented information material to patentability.

254. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to whether the pending claims of the '531 application were entitled to the priority date of the '194 application and the '442 application by extension.

Misrepresentation Regarding AIA Rules

255. In addition to his material misrepresentation of the '328 patent's priority date,

1 Abhyanker omitted material information when, during the '531 application's prosecution, he did
 2 not indicate to the USPTO that the '328 patent application should be examined under the first-to-
 3 file provisions of the America Invents Act ("AIA") because it has at least one claim with an
 4 effective filing date after March 16, 2013.

5 256. Upon information and belief, Abhyanker, a licensed patent attorney, knew that the
 6 '531 application, purportedly a continuation but in fact a continuation-in-part filed in 2014 and
 7 containing new matter, had at least one claim with an effective date after March 16, 2013.

8 257. Nevertheless, Abhyanker did not check the box provided on a USPTO form to
 9 indicate that the '531 application should be examined under AIA rules, upon information and
 10 belief, with the specific intent of deceiving the USPTO and avoiding prior art, such as the public
 11 use of Fatdoor services.

12 258. Had Abhyanker properly indicated that the '531 application should be examined
 13 according to the AIA, one or more claims would have been accorded the March 10, 2014 '531
 14 application filing date, and the USPTO would have rejected those claims in view of Kaplan.

15 259. Abhyanker's contention that the '531 application should be examined according to
 16 pre-AIA rules misrepresented information material to patentability.

17 260. Upon information and belief, Abhyanker specifically intended to deceive the
 18 USPTO as to whether the pending claims of the '531 application were entitled to be examined
 19 under pre-AIA rules.

20 **Failure to Disclose References Relied on by USPTO During the Prosecution of the '844**
 21 **Application**

22 261. The '091 patent that issued on the '844 application discloses and claims similar
 23 subject matter as the '328 application. The '091 patent claims to be a continuation-in-part of the
 24 '194 application, and the '328 claims to be a continuation of the '194 application.

25 262. Accordingly, material prior art to the '844 application would also have been
 26 material prior art to the '531 application.

27 263. The USPTO cited several references in support of the non-final rejection of the
 28 '844 application on March 17, 2014. These include U.S. Patent No. 8,650,103, by Wilf et al.

1 ("Wilf"); Publication No. US-2013/0282842, by Blecon et al. ("Blecon"); Publication No. US-
 2 2011/0231268, by Ungos ("Ungos"); and an article from Wired.com entitled "Fatdoor CEO Talks
 3 about balancing security with community," by Russell ("Russell").

4 264. That the USPTO cited these references in support of its rejection of the '844
 5 application confirms that the USPTO would have considered them prior art material to the
 6 patentability of the '531 application.

7 265. Abhyanker nonetheless did not disclose Wilf, Blecon, Ungos, or Russell during
 8 prosecution of the '513 application even though he knew that the USPTO would have considered
 9 them to be prior art material to patentability.

10 266. Upon information and belief, Abhyanker specifically intended to deceive the
 11 USPTO as to the existence of material prior art such as Wilf, Blecon, Ungos, and Russell.

Failure to Disclose Nextdoor.com Website

12 267. Abhyanker also did not disclose the existence of Defendant's website,
 13 Nextdoor.com, and services and features provided therein, in an information disclosure statement
 14 during prosecution of the '531 application.

15 268. Nextdoor.com launched to the general public in October 2011, although it had
 16 been in public beta testing since early 2011.

17 269. Given that Abhyanker has accused the Nextdoor.com website of infringing the
 18 '328 patent, Abhyanker knew that the USPTO would have considered the Nextdoor.com website
 19 material to patentability.

20 270. Upon information and belief, and in view of Abhyanker's knowledge that his
 21 claims of priority were improper, as well his contemporaneous knowledge of the USPTO's
 22 rejection of such a priority date in connection with the '612 application that led to the '545 patent,
 23 as explained below, Abhyanker knew that the USPTO would have considered Nextdoor.com to
 24 be prior art material to the patentability of the '531 application.

25 271. Abhyanker nonetheless did not disclose the Nextdoor.com website during
 26 prosecution of the '531 application even though he knew that the USPTO would have considered
 27 it to be prior art material to patentability.

272. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as the Nextdoor.com website.

Conclusion

273. In sum, on information and belief, Abhyanker, the inventor and patent attorney for the '328 patent, misrepresented and omitted material information with the intent to deceive the USPTO to ensure the issuance of the '328 patent.

274. By reason of this inequitable conduct, the '328 patent and all related patents are unenforceable.

275. The '328 patent is further unenforceable as a result of Abhyanker's inequitable conduct committed during the prosecution of related applications, including without limitation U.S. Patent Application Nos. 14/151,844, addressed above, and 14/144,612, addressed above.

SIXTEENTH DEFENSE: FAILURE TO JOIN AN INDISPENSABLE PARTY

276. Plaintiff has failed to join an indispensable party or parties to this action, including without limitation persons or entities who may have an ownership interest in the '328 patent, the '091 patent, and/or the '545 patent.

COUNTERCLAIMS

In addition to its affirmative defenses, Counterclaimant Nextdoor.com, Inc. further asserts the following counterclaims against Counterclaim Defendants Fatdoor, Inc. and Raj Abhyanker and alleges as follows:

THE PARTIES

1. Counterclaimant Nextdoor.com, Inc. ("Nextdoor") is a corporation organized and existing under the laws of the State of Delaware and has its principal place of business at 760 Market Street, Suite 300, San Francisco, CA 94102.

2. On information and belief and through its own admission in its Complaint, Counterclaim Defendant Fatdoor, Inc. is a Delaware corporation with its principal place of business in Mountain View, CA.

3. On information and belief, Counterclaim Defendant Raj Abhyanker (“Abhyanker”) is an individual residing in Cupertino, CA. On information and belief, Abhyanker

1 is the alter ego of Fatdoor. In particular, on information and belief, Abhyanker directs and
 2 controls the activities of Fatdoor without observing distinctions between his activities and those
 3 of Fatdoor and uses Fatdoor as an instrumentality of his own interests, including, without
 4 limitation, by freely transferring rights and assets as between himself and Fatdoor and other
 5 entities that he controls, such that to recognize Fatdoor as a separate entity would cause inequity
 6 and injustice. Fatdoor and its alter ego, Abhyanker, will be collectively referred to as “Fatdoor.”

7 THE PATENTS

8 4. U.S. Patent No. 8,775,328 (the “’328 patent”), entitled “Geo-Spatially Constrained
 9 Private Social Network,” issued on July 8, 2014.

10 5. U.S. Patent No. 8,732,091 (the “’091 patent”), entitled “Security in a Geo-Spatial
 11 Environment,” issued on May 20, 2014. Upon information and belief, Abhyanker purportedly
 12 assigned certain interests in the ’091 patent to Fatdoor on June 18, 2014 and recorded an
 13 assignment to that effect with the USPTO on the same day. Abhyanker purported to own a 50%
 14 interest in the ’091 patent at the time this action was filed and, to the extent that he maintained
 15 any such interests, Abhyanker continues to maintain certain interests in the ’091 patent.

16 6. U.S Patent No. 8,738,545 (the “’545 patent”), entitled “Map Based Neighborhood
 17 Search and Community Contribution,” issued on May 27, 2014, purportedly to Abhyanker. Upon
 18 information and belief, Abhyanker purportedly assigned certain interests in the ’545 patent to
 19 Fatdoor after the filing of Nextdoor’s original counterclaims. Abhyanker recorded an assignment
 20 to that effect with the USPTO on June 25, 2014 that purports to have been executed on June 24,
 21 2014. Upon information and belief, Abhyanker purported to own all interests in the ’545 patent
 22 at the time of Nextdoor’s counterclaims and, to the extent that he maintained any such interests,
 23 Abhyanker continues to maintain certain interests in the ’545 patent.

24 JURISDICTION AND VENUE

25 7. Nextdoor counterclaims against Fatdoor and Abhyanker pursuant to the patent
 26 laws of the United States, Title 35 of the United States Code, laws authorizing actions for
 27 declaratory judgment in the courts of the United States, 28 U.S.C. §§ 2201 and 2202, and Federal
 28 Rule of Civil Procedure 13.

1 8. This Court has jurisdiction over these Counterclaims pursuant to 28 U.S.C.
2 §§ 1331, 1338(a), 2201(a), and 2202.

3 9. This Court has personal jurisdiction over Fatdoor and Abhyanker by virtue, *inter*
4 *alia*, of their filing of the Complaint in this Court and their residence in this District.

5 | 10. Venue is proper in this District pursuant to 28 U.S.C. §§ 1331 and 1333.

6 11. An actual controversy exists between Nextdoor, on the one hand, and Fatdoor and
7 Abhyanker, on the other, with respect to the '328 patent, the '091 patent, and the '545 patent, by
8 virtue of the allegations of Fatdoor's FAC in this action and Nextdoor's answer thereto—*i.e.*, as
9 to whether the '328 patent, the '091 patent, and the '545 patent are invalid and/or not infringed by
10 Nextdoor's products and services.

**FIRST COUNTERCLAIM:
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '328 PATENT**

13 12. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference
14 as if fully restated herein.

13. Fatdoor claims in its FAC to be the “full owner of interest in” the ’328 patent.

16 14. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the '328
17 patent.

18 15. Nextdoor has not and does not infringe any valid and enforceable claim of the '328
19 patent, either literally or by the doctrine of equivalents.

20 16. Absent a declaration of non-infringement of the '328 patent, Fatdoor will continue
21 to assert the '328 patent against Nextdoor and will in this way cause damage to Nextdoor.

22 17. Accordingly, Nextdoor is entitled to a judgment from this Court that the '328
23 patent is not infringed by any Nextdoor product or service, either literally or under the doctrine of
24 equivalents.

**SECOND COUNTERCLAIM:
DECLARATORY JUDGMENT OF INVALIDITY OF THE '328 PATENT**

27 18. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference
28 as if fully restated herein.

19. Fatdoor claims in its FAC to be the “full owner of interest in” the ’328 patent.
20. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the ’328 patent.

21. One or more claims of the '328 patent are invalid for failure to meet one or more of the conditions for patentability specified in Title 35, U.S.C., or the rules, regulations, and law related thereto, including, without limitation, 35 U.S.C. §§ 101, 102, 103, and 112.

22. Absent a declaration of invalidity of the '328 patent, Fatdoor will continue to assert the '091 patent against Nextdoor and will in this way cause damage to Nextdoor.

9 23. Accordingly, Nextdoor seeks a declaration that one or more claims of the '328
10 patent are invalid.

**THIRD COUNTERCLAIM:
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '091 PATENT**

13 24. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference
14 as if fully restated herein.

15 25. Fatdoor claims in its FAC to be the “full owner of interest in” the ’091 patent.
16 Abhyanker purports to have transferred certain ownership interests in the ’091 patent to Fatdoor,
17 Inc., but, upon information and belief, such transfer failed to transfer certain rights in the ’091
18 patent.

19 26. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the '091
20 patent.

21 27. Nextdoor has not and does not infringe any valid and enforceable claim of the '091
22 patent, either literally or by the doctrine of equivalents.

23 28. Absent a declaration of non-infringement of the '091 patent, Counterclaim
24 Defendants will continue to assert the '091 patent against Nextdoor and will in this way cause
25 damage to Nextdoor.

26 29. Accordingly, Nextdoor is entitled to a judgment from this Court that the '091
27 patent is not infringed by any Nextdoor product or service, either literally or under the doctrine of
28 equivalents.

**FOURTH COUNTERCLAIM:
DECLARATORY JUDGMENT OF INVALIDITY OF THE '091 PATENT**

30. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

31. Fatdoor claims in its FAC to be the “full owner of interest in” the ’091 patent. Abhyanker purports to have transferred certain ownership interests in the ’091 patent to Fatdoor, Inc., but, upon information and belief, such transfer failed to transfer certain rights in the ’091 patent.

32. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the '091 patent.

33. One or more claims of the '091 patent are invalid for failure to meet one or more of the conditions for patentability specified in Title 35, U.S.C., or the rules, regulations, and law related thereto, including, without limitation, 35 U.S.C. §§ 101, 102, 103, and 112.

34. Absent a declaration of invalidity of the '091 patent, Counterclaim Defendants will continue to assert the '091 patent against Nextdoor and will in this way cause damage to Nextdoor.

35. Accordingly, Nextdoor seeks a declaration that one or more claims of the '091 patent are invalid.

**FIFTH COUNTERCLAIM:
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '545 PATENT**

36. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

37. The '545 patent was issued by the United States Patent and Trademark office on May 27, 2014, purportedly to Abhyanker. Upon information and belief, Abhyanker purportedly assigned certain interests in the '545 patent to Fatdoor, Inc. after the filing of Nextdoor's original counterclaims. Abhyanker recorded an assignment to that effect with the USPTO on June 25, 2014 that purports to have been executed on June 24, 2014. Fatdoor now claims in its FAC to be the "full owner of interest in" the '545 patent. Upon information and belief, Abhyanker purported

to own all interests in the '545 patent at the time of Nextdoor's original counterclaims and, to the extent that he maintained any such interests, Abhyanker continues to maintain certain interests in the '545 patent.

38. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the '545 patent.

39. Nextdoor has not and does not infringe any valid and enforceable claim of the '545 patent, either literally or by the doctrine of equivalents.

40. Absent a declaration of non-infringement of the '545 patent, Counterclaim Defendants will continue to pursue claims of infringement with respect to the '545 patent against Nextdoor and will in this way cause damage to Nextdoor.

41. Accordingly, Nextdoor is entitled to a judgment from this Court that the '545 patent is not infringed by any Nextdoor product or service, either literally or under the doctrine of equivalents.

**SIXTH COUNTERCLAIM:
DECLARATORY JUDGMENT OF INVALIDITY OF THE '545 PATENT**

42. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

43. The '545 patent was issued by the United States Patent and Trademark office on May 27, 2014, purportedly to Abhyanker. Upon information and belief, Abhyanker purportedly assigned certain interests in the '545 patent to Fatdoor, Inc. after the filing of Nextdoor's original counterclaims. Abhyanker recorded an assignment to that effect with the USPTO on June 25, 2014 that purports to have been executed on June 24, 2014. Fatdoor now claims in its FAC to be the "full owner of interest in" the '545 patent. Upon information and belief, Abhyanker purported to own all interests in the '545 patent at the time of Nextdoor's original counterclaims and, to the extent that he maintained any such interests, Abhyanker continues to maintain certain interests in the '545 patent.

44. Fatdoor asserts in this action that Nextdoor has infringed and is infringing the '545 patent.

45. One or more claims of the '545 patent are invalid for failure to meet one or more of the conditions for patentability specified in Title 35, U.S.C., or the rules, regulations, and law related thereto, including, without limitation, 35 U.S.C. §§ 101, 102, 103, and 112.

46. Absent a declaration of invalidity of the '545 patent, Counterclaim Defendants are likely to pursue claims of infringement with respect to the '545 patent against Nextdoor and will in this way cause damage to Nextdoor.

47. Accordingly, Nextdoor seeks a declaration that one or more claims of the '545 patent are invalid.

**SEVENTH COUNTERCLAIM:
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE '091 PATENT**

Introduction

48. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

49. The '091 patent, and each claim thereof, is unenforceable due to inequitable conduct during its prosecution.

50. During prosecution of the '091 patent, Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized information that he knew would have been important to a reasonable examiner in determining whether to issue the patent.

51. Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized this material information with a specific intent to deceive the United States Patent and Trademark Office (“USPTO”).

52. Abhyanker filed U.S. Patent Application No. 14/151,844 (the “’844 application”) on January 10, 2014. The ’844 application issued as the ’091 patent.

53. Abhyanker, the named inventor of the '844 application, served as patent prosecution counsel for the '844 application.

54. Abhyanker's USPTO registration number, submitted with his filings in the '844 application, is Reg. No. 45474

1 **Improper Claims of Priority**

2 55. Upon information and belief, Abhyanker, as a licensed patent attorney, is familiar
3 with the rules governing the patent process.

4 56. Specifically, upon information and belief, Abhyanker knew at the time he filed the
5 '844 application that in order to claim the benefit of an earlier application's priority date, 1) the
6 invention disclosed in the earlier application must support the claims of the later application, and
7 2) the two applications must have been co-pending.

8 57. The USPTO issued and mailed a non-final rejection on March 17, 2014, rejecting
9 all pending claims of the '844 application in light of Kaplan, Dan, "Fatdoor turns neighborhoods
10 into online social networks," May 28, 2007 ("Kaplan").

11 58. Kaplan described the public use and sale of Fatdoor services offered by a previous
12 company called Fatdoor, Inc. ("Fatdoor I") which Raj Abhyanker, the CEO of the later entity,
13 Plaintiff Fatdoor, Inc. also served as CEO.

14 59. Upon information and belief, Abhyanker and therefore Plaintiff Fatdoor, Inc. knew
15 that Fatdoor I offered services similar to those claimed in the pending claims of the '844
16 application.

17 60. The USPTO rejected independent claim 1 of the '844 application as anticipated by
18 Kaplan because it "discloses a neighborhood communication system: a privacy server: to verify
19 that each user of the community network lives at a residence associated with a claimable
20 residential address of the community network formed through a social community module of a
21 privacy server using a processor and a memory; to obtain from each user of the community
22 network, using the processor of a computing device, member data associated with each user, the
23 member data including an address; to associate the address with a profile of each user; to
24 determine a location of each user based on the member data; to store the member data in a
25 database; and to obtain a personal address privacy preference from each user, the personal address
26 privacy preference specifying if the address should be displayed to other users; and a mapping
27 server associated with the privacy server through a network to generate a geospatial
28 representation of a set of points on a map defining residences associated with each use of the

1 community network having the member data.”

2 61. The USPTO rejected independent claim 13 of the ’844 application as anticipated
 3 by Kaplan because it “discloses [a] method of organizing a community network, comprising:
 4 verifying that each user of the community network lives at a residence associated with a
 5 claimable residential address of the community network formed through a social community
 6 module of a privacy server using a processor and a memory; obtaining from each user of the
 7 community network, using the processor of a computing device, member data associated with
 8 each user, the member data including an address; associating the address with a profile of each
 9 user; determining a location of each user based on the member data; storing the member data in a
 10 database; and obtaining a personal address privacy preference from each user, the personal
 11 address privacy preference specifying if the address should be displayed to other users.”

12 62. The USPTO rejected independent claim 25 of the ’844 application as anticipated
 13 by Kaplan because it “discloses a neighborhood communication system comprising: a privacy
 14 server: to verify that each user of the community network lives at a residence associated with a
 15 claimable residential address of the community network formed through a social community
 16 module of a privacy server using a processor and a memory; to obtain from each user of the
 17 community network, using the processor of a computing device, member data associated with
 18 each user, the member data including an address; to associate the address with a profile of each
 19 user; to determine a location of each user based on the member data; to store the member data in a
 20 database; and to obtain a personal address privacy preference from each user, the personal address
 21 privacy preference specifying if the address should be displayed to other users; a network; and a
 22 mapping server associated with the privacy server through a network: to generate a geospatial
 23 representation of a set of points on a map defining residences associated with each use of the
 24 community network having the member data, determine that a marker is colliding with another
 25 marker simultaneously displayed in a map based on an overlap area of the marker with the
 26 another marker, automatically create a group pointer that replaces the marker and the another
 27 marker on the map, generate a view of the marker and the another marker when a user selects the
 28 group pointer, and determine that the marker, the another marker, and different markers are

1 associated with a shared structure based on address data associated with occupants represented
 2 through the marker, the another marker and the different markers.”

3 63. Abhyanker submitted a Response to Non-Final Office Action on March 26, 2014
 4 (the “Response”).

5 64. In the Response, Abhyanker contested the USPTO’s determination that Kaplan
 6 anticipated the pending claims of the ’844 application.

7 65. Abhyanker represented to the USPTO that Kaplan was disqualified as prior art on
 8 the ground that the ’844 application was entitled to a priority date of March 17, 2006.

9 66. Abhyanker represented to the USPTO that the pending claims of the ’844
 10 application were entitled to claim priority to U.S. Patent Application 11/653,194 (the “’194
 11 application”), filed on January 12, 2007, which in turn claimed priority to U.S. Patent
 12 Application No. 11/603,442 (the “’442 application”), filed on November 22, 2006.

13 67. The ’442 application claims priority to U.S. Provisional Application 60/783,226,
 14 filed on March 17, 2006.

15 68. Abhyanker’s claims for priority in the ’844 application to the ’442 and ’194
 16 applications are improper. For example, a pending claim is entitled to the benefit of the filing
 17 date of an earlier-filed application only if that earlier-filed application discloses each and every
 18 element of the pending claim.

19 69. As such, by representing to the USPTO that the pending claims of the ’844
 20 application were entitled to the filing dates of the ’194 and ’442 applications, Abhyanker in effect
 21 represented that the specifications of the ’194 and ’442 applications each fully disclosed the
 22 subject matter of the pending claims of the ’844 application.

23 70. This representation by Abhyanker to the USPTO as to the ’194 application was
 24 incorrect. None of the pending ’844 claims was supported by the ’194 application.

25 71. By way of example, the concept of a “privacy preference,” a central feature of all
 26 claims of the ’844 application, is found nowhere in the disclosures of the ’194 application.

27 72. Similarly, Abhyanker’s representation to the USPTO as to the ’442 application
 28 was incorrect. None of the pending claims in the ’844 application was supported by the ’442

1 application

2 73. By way of example, the concept of a “privacy preference,” a central feature of all
 3 claims of the ’844 application, is found nowhere in the disclosures of the ’442 application.

4 74. On information and belief, Abhyanker intentionally made these representations,
 5 knowing them to be incorrect, in order to mislead the USPTO as to the content of the ’442 and
 6 ’194 applications.

7 75. Abhyanker is the sole inventor listed on the ’442 and ’194 applications, filed in
 8 2006 and 2007 respectively. Abhyanker thus is familiar with the subject matter disclosed in those
 9 applications.

10 76. Given his status the sole inventor of the ’442 and ’194 applications, Abhyanker
 11 knew that those applications did not fully support the pending claims of the ’844 application,
 12 including without limitation that those applications did not disclose a “privacy preference.”

13 77. Additionally, the ’844 application fails to meet the co-pendency requirement at
 14 least with respect to the ’442 application. The ’442 application was abandoned on June 24, 2009.
 15 Abhyanker later filed the ’844 application on January 10, 2014, identifying the ’844 application
 16 as a continuation-in-part of the ’442 application.

17 78. Thus, the ’844 application and ’442 application were not co-pending.

18 79. Upon information and belief, Abhyanker recognized after he filed the ’844
 19 application that co-pendency was lacking.

20 80. On January 21, 2014—over four years after the ’442 application was abandoned
 21 and eleven days after filing the ’844 application—Abhyanker filed a request for continued
 22 examination of the ’442 application in a sham effort to establish co-pendency.

23 81. However, because the ’442 application was abandoned at the time Abhyanker filed
 24 the ’844 application, the ’844 application was not co-pending with the ’442 application.

25 82. Upon information and belief, Abhyanker knew that the ’442 application and ’194
 26 application disclosures did not support any of the pending claims of the ’844 application and that
 27 co-pendency was lacking at least between the ’091 patent application and the ’442 application.

28 83. Abhyanker’s misrepresentations concerning the co-pendency of the ’442

1 application and the entitlement of the '844 application to the priority dates of the '194 and '442
 2 applications were material, as evidenced at least by the USPTO's rejection of the pending claims
 3 of the '844 application in light of Kaplan and the USPTO's withdrawal its rejection in response to
 4 Abhyanker's misrepresentations concerning the '194 and '442 applications.

5 84. Absent these misrepresentations, the USPTO would not have disqualified Kaplan
 6 as prior art.

7 85. Moreover, upon information and belief, Abhyanker knew that his improper claims
 8 of priority to the '442 and '194 applications were material to the patentability of the pending
 9 claims of the '844 application.

10 86. Abhyanker exhibited as much during the prosecution of the '844 application. As
 11 noted above, in his Response, Abhyanker argued that Kaplan should be disqualified because the
 12 pending claims of the '844 application were entitled to claim the benefit of the '194 and '442
 13 applications.

14 87. Upon further information and belief, Abhyanker had the specific intent of claiming
 15 priority to the '442 and '194 applications in an attempt to deceive the USPTO and avoid prior art,
 16 such as the public use of the Fatdoor services by Fatdoor I, that a reasonable examiner would rely
 17 upon to reject the pending claims of the '844 application. Those claims, now issued as the '091
 18 patent, would stand rejected but for Abhyanker's improper claims of priority to the '194 and '442
 19 applications.

20 88. Abhyanker's claims of priority in the '844 application misrepresented information
 21 material to patentability.

22 89. Upon information and belief, Abhyanker specifically intended to deceive the
 23 USPTO as to whether the pending claims of the '844 application were entitled to the priority date
 24 of either the '194 application or '442 application.

25 **Misrepresentation Regarding AIA Rules**

26 90. In addition to his material misrepresentation of the '091 patent's priority date,
 27 Abhyanker omitted material information when, during the '844 application's prosecution, he did
 28 not indicate to the USPTO that the '091 patent application should be examined under the first-to-

1 file provisions of the America Invents Act (“AIA”) because it has at least one claim with an
 2 effective filing date after March 16, 2013.

3 91. Upon information and belief, Abhyanker, a licensed patent attorney, knew that the
 4 ’844 application, a continuation-in-part filed in 2014, had at least one claim with an effective date
 5 after March 16, 2013.

6 92. Nevertheless, Abhyanker did not check the box provided on a USPTO form to
 7 indicate that the ’844 application should be examined under AIA rules, upon information and
 8 belief, with the specific intent of deceiving the USPTO and avoiding prior art, such as the public
 9 use of Fatdoor services.

10 93. Had Abhyanker properly indicated that the ’844 application should be examined
 11 according to the AIA, one or more claims would have been accorded the January 10, 2014 ’844
 12 application filing date, and the USPTO would have rejected those claims in view of Kaplan.

13 94. Abhyanker’s contention that the ’844 application should be examined according to
 14 pre-AIA rules misrepresented information material to patentability.

15 95. Upon information and belief, Abhyanker specifically intended to deceive the
 16 USPTO as to whether the pending claims of the ’844 application were entitled to be examined
 17 under pre-AIA rules.

18 **Failure to Disclose References Relied on by the USPTO During Prosecution of Another**
 19 **Patent Application**

20 96. During prosecution of the ’844 application, Abhyanker contended that the ’844
 21 application was entitled to the benefit of the ’194 application’s priority date.

22 97. This contention was an effort to support his improper priority claims.

23 98. Accordingly, and by Abhyanker’s own representation, the ’194 application
 24 discloses similar subject matter to that claimed by the ’844 application.

25 99. Abhyanker did not disclose the following references to the USPTO during the
 26 prosecution of the ’844 application: Publication No. US-2001/0005829 by Raveis (“Raveis”);
 27 Publication No. US-2006/0022048 by Johnson (“Johnson”); and Publication No. US-
 28 2007/1056429 by Godar (“Godar”).

1 100. The USPTO cited Raevis in support of a non-final rejection of the '194 application
 2 issued on May 10, 2011.

3 101. The USPTO cited Johnson in support of a final rejection of the '194 application
 4 issued on December 10, 2012.

5 102. The USPTO cited Godar in support of a non-final rejection of the '194 application
 6 issued on January 28, 2014.

7 103. That the USPTO cited these references in support of its rejection of the '194
 8 application, particularly in view of Abhyanker's argument of this application's relevance to the
 9 '844 application's claims, confirms that the USPTO would have considered them prior art
 10 material to the patentability of the '844 application.

11 104. Upon information and belief, and in view of Abhyanker's knowledge that his
 12 claims of priority were improper (as well his contemporaneous knowledge of the USPTO's
 13 rejection of such a priority date in connection with the '612 application that led to the '545 patent,
 14 as explained below), Abhyanker knew that the USPTO would have considered these references to
 15 be prior art material to the patentability of the '844 application.

16 105. Abhyanker nonetheless did not disclose Raevis, Johnson, or Godar during
 17 prosecution of the '844 application even though he knew that the USPTO would have considered
 18 them to be prior art material to patentability.

19 106. Upon information and belief, Abhyanker specifically intended to deceive the
 20 USPTO as to the existence of material prior art such as Raevis, Johnson, and Godar.

21 **Failure to Disclose References Identified by the USPTO During Prosecution of Another**
 22 **Patent Application**

23 107. Abhyanker also did not disclose the following references to the USPTO during the
 24 prosecution of the '844 application: Publication No. US-2004/0039581 by Wheeler ("Wheeler");
 25 Publication No. US-2006/0190279 by Heflin ("Heflin"); Publication No. US-2003/022807 by
 26 Hoffman ("Hoffman"); and Publication No. US-2005/0203768 by Florance ("Florance").

27 108. In a non-final rejection of the '194 application issued on January 28, 2014, the
 28 USPTO notified Abhyanker that it considered all of these references relevant to the '194

1 application even though it had not specifically outlined their application under 35 U.S.C. §§ 102
 2 or 103. The USPTO advised Abhyanker to review these references in particular.

3 109. That the USPTO identified these references as relevant in support of its rejection
 4 of the '194 application, particularly in view of Abhyanker's arguments that the '194 application
 5 fully discloses the invention(s) claimed in the '844 application, confirms that the USPTO would
 6 have considered it to be prior art material to the patentability of the '844 application.

7 110. Upon information and belief, and in view of Abhyanker's knowledge that his
 8 claims of priority were improper (as well his contemporaneous knowledge of the USPTO's
 9 rejection of such a priority date in connection with the '612 application that led to the '545 patent,
 10 as explained below), Abhyanker knew that the USPTO would have considered these references to
 11 be prior art material to the patentability of the '844 application.

12 111. Abhyanker nonetheless did not disclose Wheeler, Heflin, Hoffman, or Florance
 13 during prosecution of the '844 application even though he knew that the USPTO would have
 14 considered them to be prior art material to patentability.

15 112. Upon information and belief, Abhyanker specifically intended to deceive the
 16 USPTO as to the existence of material prior art such as Wheeler, Heflin, Hoffman, and Florance.

Failure to Disclose Nextdoor.com Website

18 113. Abhyanker also did not disclose the existence of Defendant's website,
 19 Nextdoor.com, and services and features provided therein, in an information disclosure statement
 20 during prosecution of the '844 application.

21 114. Nextdoor.com launched to the general public in October 2011, although it had
 22 been in public beta testing since early 2011.

23 115. Given that Abhyanker has, on the day of issuance, accused the Nextdoor.com
 24 website of infringing the '091 patent, Abhyanker knew that the USPTO would have considered
 25 the Nextdoor.com website material to patentability.

26 116. Upon information and belief, and in view of Abhyanker's knowledge that his
 27 claims of priority were improper, as well his contemporaneous knowledge of the USPTO's
 28 rejection of such a priority date in connection with the '612 application that led to the '545 patent,

as explained below, Abhyanker knew that the USPTO would have considered Nextdoor.com to be prior art material to the patentability of the '844 application.

117. Abhyanker nonetheless did not disclose the Nextdoor.com website during prosecution of the '844 application even though he knew that the USPTO would have considered it to be prior art material to patentability.

118. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as the Nextdoor.com website.

Conclusion

119. In sum, on information and belief, Abhyanker, the inventor and patent attorney for the '091 patent, misrepresented and omitted material information with the intent to deceive the USPTO to ensure the issuance of the '091 patent.

120. By reason of this inequitable conduct, the '091 patent and all related patents are unenforceable.

121. Absent a declaration of unenforceability of the '091 patent, Counterclaim Defendants are likely to continue to pursue claims of infringement with respect to the '091 patent against Nextdoor and will in this way cause damage to Nextdoor.

122. The '091 patent is further unenforceable as a result of Abhyanker's inequitable conduct committed during the prosecution of related patent applications, including without limitation U.S. Patent Application No. 14/203,531, addressed below, and U.S. Patent Application No. 14/144,612, addressed below.

123. Accordingly, Nextdoor seeks a declaration that the '091 patent is unenforceable.

**EIGHTH COUNTERCLAIM:
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE '545 PATENT**

Introduction

124. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

125. The '545 patent, and each claim thereof, is unenforceable due to inequitable conduct during its prosecution.

126. During prosecution of the '545 patent, Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized information that he knew would have been important to a reasonable examiner in determining whether to issue the patent.

127. Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized this material information with a specific intent to deceive the United States Patent and Trademark Office (“USPTO”).

128. Abhyanker filed U.S. Patent Application No. 14/144,612 (the “’612 application”) on December 31, 2013. The ’612 application issued as the ’545 patent.

129. Abhyanker, the named inventor of the '612 application, served as patent prosecution counsel for the '612 application.

130. Abhyanker's USPTO registration number, submitted with his filings in the '612 application, is Reg. No. 45474.

Improper Claims of Priority

131. Upon information and belief, Abhyanker, as a licensed patent attorney, is familiar with the rules governing the patent process.

132. Specifically, upon information and belief, Abhyanker knew at the time he filed the '612 application that in order to claim the benefit of an earlier application's priority date, 1) the invention disclosed in the earlier application must support the claims of the later application, and 2) the two applications must have been co-pending.

133. The USPTO issued and mailed a non-final rejection on March 6, 2014, rejecting all pending claims of the '612 application.

134. The USPTO's rejection stood in part on the ground that Abhyanker's priority claims were improper and that, instead, the claims of the '612 application were entitled to an effective filing date of December 31, 2013.

135. The USPTO further based its rejection under 35 U.S.C. 103(a), finding that the claims of the '612 application were unpatentable over Abhyanker's own '442 application and U.S. Patent Application No. 11/717,807 (the "'087 application), filed in 2006 and 2007, respectively.

1 136. Abhyanker submitted a response to the non-final office action on March 10, 2014
 2 (the “’612 Response”).

3 137. In the ’612 Response, Abhyanker contested the USPTO’s determination that the
 4 claims of the ’612 application were entitled to an effective filing date of December 31, 2013.

5 138. Abhyanker represented to the USPTO that the pending claims of the ’612
 6 application were entitled to claim priority to the ’194 application, filed on January 12, 2007,
 7 which in turn claimed priority to the ’442, filed on November 22, 2006.

8 139. The ’442 application claims priority to U.S. Provisional Application 60/783,226,
 9 filed on March 17, 2006.

10 140. Abhyanker’s claims for priority in the ’844 application to the ’442 and ’194
 11 applications are improper. For example, a pending claim is entitled to the benefit of the filing
 12 date of an earlier-filed application only if that earlier-filed application discloses each and every
 13 element of the pending claim.

14 141. In the Response, Abhyanker specifically represented that the pending claims of the
 15 ’612 application were “entirely supported” in the specification of the ’194 application, as well as
 16 by the specifications of two other patent applications, Nos. 11/731,465 (the “’465 application”)
 17 and 11/827,400 (the “’400 application”).

18 142. This representation by Abhyanker to the USPTO as to the ’194, ’465, and ’400
 19 applications was incorrect. None of the pending claims of the ’612 application was supported by
 20 these applications.

21 143. By way of example, the concept of conducting “high value crime and safety
 22 related discussions,” which is central to all claims of the ’612 application, is found nowhere in the
 23 disclosures of the ’194, ’465, or ’400 applications.

24 144. On information and belief, Abhyanker, a licensed patent attorney, intentionally
 25 made these representations, knowing them to be incorrect, in order to mislead the USPTO as to
 26 the content of the ’194, ’465, and ’400 applications.

27 145. Abhyanker is the sole inventor listed on the ’194, ’465, and ’400 applications, all
 28 filed in 2007. Abhyanker thus is familiar with the subject matter disclosed in those applications.

1 146. Given his status as the sole inventor of the '194, '465, and '400 applications,
 2 Abhyanker knew that those applications did not fully support the pending claims of the '612
 3 application, including without limitation that those applications did not disclose the concept of
 4 conducting "high value crime and safety related discussions."

5 147. Additionally, the '612 application fails to meet the co-pendency requirement at
 6 least with respect to the '442 application. The '442 application was abandoned on June 24, 2009.
 7 Abhyanker later filed the '612 application on December 31, 2013.

8 148. Thus, the '612 application and '442 application were not co-pending.

9 149. Upon information and belief, Abhyanker recognized after he filed the '612
 10 application that co-pendency was lacking.

11 150. On January 21, 2014—over four years after the '442 application was abandoned
 12 and twenty-one days after filing the '612 application—Abhyanker filed a request for continued
 13 examination of the '442 application in a sham effort to establish co-pendency.

14 151. However, because the '442 application was abandoned at the time Abhyanker filed
 15 the '612 application, the '612 application was not co-pending with the '442 application.

16 152. Upon information and belief, Abhyanker knew that the '442 application and '194
 17 application disclosures did not support any of the pending claims of the '612 application and that
 18 co-pendency was lacking at least between the '612 patent application and the '442 application.

19 153. Abhyanker nonetheless represented in the Response of March 10, 2014 that the
 20 '612 application was entitled to the benefit of the '442 application's priority date.

21 **Failure to Disclose Kaplan Reference Relied on by the USPTO or Other Fatdoor References
 22 During the Prosecution of Another Application**

23 154. Abhyanker also did not disclose the following reference to the USPTO during the
 24 prosecution of the '612 application: Kaplan, Dan, "Fatdoor turns neighborhoods into online social
 25 networks," May 28, 2007 ("Kaplan").

26 155. Kaplan describes the public use and sale of Fatdoor services offered by a previous
 27 company called Fatdoor, Inc. ("Fatdoor I") of which Raj Abhyanker, the CEO of the later entity,
 28 Plaintiff Fatdoor, Inc. also served as CEO.

1 156. More generally, Abhyanker failed to disclose any references describing services
 2 offered by Fatdoor I, including the fatdoor.com website.

3 157. Upon information and belief, Abhyanker knew that Fatdoor I offered services
 4 similar to those claimed in the pending claims of the '612 application.

5 158. Abhyanker became aware of Kaplan in particular no later than March 17, 2014, at
 6 which time Kaplan was cited by the USPTO during prosecution of the '844 application in
 7 connection with a non-final rejection.

8 159. Abhyanker did not disclose the office action wherein the examiner cited Kaplan.

9 160. Abhyanker was personally involved in the development of Fatdoor I and was
 10 aware of services made publicly available at fatdoor.com.

11 161. The '091 and '545 patents disclose and claim similar subject matter, and the '091
 12 patent claims to be a continuation-in-part of the '612 application.

13 162. Accordingly, material prior art to the '844 application would also have been
 14 material prior art to the '612 application.

15 163. Upon information and belief, Abhyanker knew that the USPTO would have found
 16 Kaplan to be material to patentability because the USPTO had previously relied on Kaplan in
 17 issuing a rejection of the '844 application.

18 164. During the prosecution of the '844 application, Abhyanker argued that Kaplan was
 19 not prior art to the '844 application because the '844 application was entitled to a priority date
 20 prior to Kaplan's publication date of May 28, 2007, in particular, that of the '442 application,
 21 filed November 22, 2006.

22 165. During the prosecution of the '612 application, Abhyanker argued that the '612
 23 patent was also entitled to the '442 application's priority date.

24 166. The USPTO rejected Abhyanker's claim of priority for the '612 application,
 25 instead according its claims an effective filing date of December 31, 2013. The USPTO
 26 accordingly examined the '612 application under AIA rules.

27 167. Upon information and belief, Abhyanker knew that the USPTO would have
 28 considered Kaplan to be prior art to the '612 application.

168. Abhyanker nonetheless did not disclose Kaplan during prosecution of the '612 application even though he knew that the USPTO would have considered Kaplan to be prior art material to patentability.

169. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as Kaplan.

170. Upon information and belief, because Kaplan describes the operation of services then available at fatdoor.com, Abhyanker knew that the USPTO would have considered fatdoor.com, or any reference describing it, to be prior art to the '612 application.

171. Abhyanker nonetheless did not disclose fatdoor.com, or any reference describing it, during prosecution of the '612 application even though he knew that the USPTO would have considered them to be prior art material to patentability.

172. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as fatdoor.com or any reference describing it.

**Failure to Disclose Other References Relied on by the USPTO
During the Prosecution of the '844 Application**

173. The USPTO cited several other references in support of the non-final rejection of the '844 application on March 17, 2014. These include U.S. Patent No. 8,650,103, by Wilf et al. ("Wilf"); Publication No. US-2013/0282842, by Blecon et al. ("Blecon"); Publication No. US-2011/0231268, by Ungos ("Ungos"); and an article from Wired.com entitled "Fatdoor CEO Talks about balancing security with community," by Russell ("Russell").

174. That the USPTO cited these references in support of its rejection of the '844 application confirms that the USPTO would have considered them prior art material to the patentability of the '612 application.

175. Upon information and belief, and in view of the USPTO's conclusion that the '612 application's claims were entitled to an effective filing date of December 31, 2013, Abhyanker knew that the USPTO would have considered these references to be prior art material to the patentability of the '612 application.

176. Abhyanker nonetheless did not disclose Wilf, Blecon, Ungos, or Russell during prosecution of the '612 application even though he knew that the USPTO would have considered them to be prior art material to patentability.

177. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as Wilf, Blecon, Ungos, and Russell.

Failure to Disclose References Relied on by the USPTO During the Prosecution of the '194 and '400 Applications

178. In addition, during prosecution of the '612 application, Abhyanker argued, in a March 10, 2014 response to a March 6, 2014 non-final rejection, that the independent claims of the '612 application “are entirely supported” in the specifications of the '194, '465, and '400 applications.

179. Accordingly, and by Abhyanker's own representation, the '194, '465, and '400 applications disclose similar subject matter to that claimed by the '612 application.

180. Abhyanker did not disclose the following references to the USPTO during the prosecution of the '612 application: Publication No. US-2001/0005829 by Raveis ("Raveis"); Publication No. US-2006/0022048 by Johnson ("Johnson"); Publication No. US-2007/1056429 by Godar ("Godar"); Publication No. 2008/0125969 by Chen ("Chen"); and Publication No. 2007/0203644 by Thota ("Thota").

181. The USPTO cited Raevis in support of a non-final rejection of the '194 application issued on May 10, 2011.

182. The USPTO cited Johnson in support of a final rejection of the '194 application issued on December 10, 2012.

183. The USPTO cited Godar in support of a non-final rejection of the '194 application issued on January 28, 2014.

184. The USPTO cited Chen and Thota in support of a non-final rejection of the '400 application issued on April 12, 2011

185. That the USPTO cited these references in support of its rejection of the '194 and '400 applications, particularly in view of Abhyanker's argument of these applications' relevance

to the '612 application's claims, confirms that the USPTO would have considered them prior art material to the patentability of the '612 application.

186. Upon information and belief, and in view of the USPTO’s conclusion that the ’612 application’s claims were entitled to an effective filing date of December 31, 2013, Abhyanker knew that the USPTO would have considered these references to be prior art material to the patentability of the ’612 application.

187. Abhyanker nonetheless did not disclose Raeviis, Johnson, Godar, Chen, and Thota during prosecution of the '612 application even though he knew that the USPTO would have considered them to be prior art material to patentability.

188. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to the existence of material prior art such as Raevs, Johnson, Godar, Chen, and Thota.

Failure to Disclose References Identified by the USPTO During the Prosecution of the '194 Application

189. Abhyanker also did not disclose the following references to the USPTO during the prosecution of the '612 application: Publication No. US-2004/0039581 by Wheeler ("Wheeler"); Publication No. US-2006/0190279 by Heflin ("Heflin"); Publication No. US-2003/022807 by Hoffman ("Hoffman"); and Publication No. US-2005/0203768 by Florance ("Florance").

190. In a non-final rejection of the '194 application issued on January 28, 2014, the USPTO notified Abhyanker that it considered all of these references relevant to the '194 application even though it had not specifically outlined their application under 35 U.S.C. §§ 102 or 103. The USPTO advised Abhyanker to review these references in particular.

191. That the USPTO identified these references as relevant in support of its rejection of the '194 application, particularly in view of Abhyanker's argument of this application's relevance to the '612 application's claims, confirms that the USPTO would have considered it to be prior art material to the patentability of the '612 application.

192. Upon information and belief, and in view of the USPTO’s conclusion that the ’612 application’s claims were entitled to an effective filing date of December 31, 2013, Abhyanker knew that the USPTO would have considered these references to be prior art material to the

1 patentability of the '612 application.

2 193. Abhyanker nonetheless did not disclose Wheeler, Heflin, Hoffman, and Florance
3 during prosecution of the '612 application even though he knew that the USPTO would have
4 considered them to be prior art material to patentability.

5 194. Upon information and belief, Abhyanker specifically intended to deceive the
6 USPTO as to the existence of material prior art such as Wheeler, Heflin, Hoffman, and Florance.

Failure to Disclose the Nextdoor.com Website

8 195. Abhyanker also did not disclose the existence of Defendant's website,
9 Nextdoor.com, and services and features provided therein, in an information disclosure statement
10 during prosecution of the '612 application.

11 196. Nextdoor.com launched to the general public in October 2011, although it had
12 been in public beta testing since early 2011.

13 197. Given that Abhyanker has accused the Nextdoor.com website of infringing the
14 '545 patent, Abhyanker knew that the USPTO would have considered the Nextdoor.com website
15 material to patentability.

16 198. Given that the USPTO accorded the '612 application's claims an effective filing
17 date of December 31, 2013, Abhyanker knew that the USPTO would have considered
18 Nextdoor.com to be prior art to the '612 application.

19 199. Abhyanker nonetheless did not disclose the Nextdoor.com website during
20 prosecution of the '612 application even though he knew that the USPTO would have considered
21 it to be prior art material to patentability.

22 200. Upon information and belief, Abhyanker specifically intended to deceive the
23 USPTO as to the existence of material prior art such as the Nextdoor.com website.

Conclusion

25 201. In sum, on information and belief, Raj Abhyanker, the inventor and patent attorney
26 for the '545 patent, misrepresented and omitted material information with the intent to deceive the
27 USPTO to ensure the issuance of the '545 patent.

28 202. By reason of this inequitable conduct, the '545 patent and all related patents are

unenforceable.

203. Absent a declaration of unenforceability of the '545 patent, Counterclaim Defendants are likely to continue to pursue claims of infringement with respect to the '545 patent against Nextdoor and will in this way cause damage to Nextdoor.

204. The '545 patent is further unenforceable as a result of Abhyanker's inequitable conduct committed during the prosecution of related patent applications, including without limitation U.S. Patent Application Nos. 14/203,531, addressed below, and 14/151,844, addressed above.

205. Accordingly, Nextdoor seeks a declaration that the '545 patent is unenforceable.

**NINTH COUNTERCLAIM:
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE '328 PATENT**

Introduction

206. Nextdoor incorporates paragraphs 1 through 11 of the Counterclaims by reference as if fully restated herein.

207. The '328 patent, and each claim thereof, is unenforceable due to inequitable conduct during its prosecution.

208. During prosecution of the '328 patent, Raj Abhyanker ("Abhyanker") failed to disclose, withheld, concealed, and/or mischaracterized information that he knew would have been important to a reasonable examiner in determining whether to issue the patent.

209. Abhyanker failed to disclose, withheld, concealed, and/or mischaracterized this material information with a specific intent to deceive the United States Patent and Trademark Office (“USPTO”).

210. Abhyanker filed U.S. Patent Application No. 14/203,531 (the “’531 application”) on March 10, 2014. The ’531 application issued as the ’328 patent.

211. Abhyanker, the named inventor of the '531 application, served as patent prosecution counsel for the '531 application.

212. Abhyanker's USPTO registration number, submitted with his filings in the '531 application, is Reg. No. 45474.

1 **Improper Claims of Priority**

2 213. Upon information and belief, Abhyanker, as a licensed patent attorney, is familiar
3 with the rules governing the patent process.

4 214. Specifically, upon information and belief, Abhyanker knew at the time he filed the
5 '531 application that in order to claim the benefit of an earlier application's priority date, 1) the
6 invention disclosed in the earlier application must support the claims of the later application, and
7 2) the two applications must have been co-pending.

8 215. Abhyanker represented to the USPTO that the pending claims of the '531
9 application were entitled to claim priority to U.S. Patent Application 11/653,194 (the "'194
10 application"), filed on January 12, 2007, which in turn claimed priority to U.S. Patent
11 Application No. 11/603,442 (the "'442 application"), filed on November 22, 2006.

12 216. Abhyanker further represented that the '442 and '194 applications disclosed each
13 and every element of the pending claims of the '531 application by submitting a claim chart to
14 that effect to the USPTO.

15 217. Additionally, the '531 application fails to meet the co-pendency requirement at
16 least with respect to the '442 application because the '442 application was abandoned at the time
17 Abhyanker filed the '531 application.

18 218. Upon information and belief, Abhyanker recognized that the '531 and '442
19 applications were not co-pending.

20 219. For this reason, Abhyanker sought to claim the benefit of the '442 application's
21 priority date by claiming priority to the '194 application.

22 220. However, the '194 application's disclosure did not support the pending claims of
23 the '531 application.

24 221. Upon information and belief, Abhyanker recognized that the '194 application's
25 disclosure did not support the pending claims of the '531 application.

26 222. Therefore, in a preliminary amendment dated May 12, 2014, Abhyanker inserted
27 matter into the specification of the '531 application that is not found in the '194 application's
28 disclosure.

223. In the May 12, 2014 preliminary amendment, Abhyanker asserted that no new matter had been added, but instead that such matter was incorporated from the '442 application.

224. This statement in the May 12, 2014 preliminary amendment is untrue. The '531 application adds new matter to the '194 application's disclosure.

225. Abhyanker's misrepresentations concerning the entitlement of the '531 application to the priority dates of the '194 and '442 applications were material to patentability because the examiner would have accorded the '531 application an effective filing date of no earlier than March 10, 2014 absent these misrepresentations.

226. The examiner would have then considered numerous other references to be prior art to the '531 application, including, without limitation, references describing the public use and sale of Fatdoor services offered by a previous company called Fatdoor, Inc. ("Fatdoor I") of which Raj Abhyanker, the CEO of the later entity, Plaintiff Fatdoor, Inc., also served as CEO. One such reference is Kaplan, Dan, "Fatdoor turns neighborhoods into online social networks," May 28, 2007 ("Kaplan"), which was cited in a non-final rejection of the '844 application (which issued as the '091 patent) on March 17, 2014.

227. That the USPTO cited Kaplan in a rejection of the '091 patent, which discloses and claims similar subject matter as the '531 application and which claims priority to the same '194 application, confirms that the USPTO would have considered Kaplan to be a material prior art reference if it considered Kaplan to be prior art.

228. Thus, Abhyanker's claims of priority in the '531 application misrepresented information material to patentability.

229. Upon information and belief, Abhyanker specifically intended to deceive the USPTO as to whether the pending claims of the '531 application were entitled to the priority date of the '194 application and the '442 application by extension.

Misrepresentation Regarding AIA Rules

230. In addition to his material misrepresentation of the '328 patent's priority date, Abhyanker omitted material information when, during the '531 application's prosecution, he did not indicate to the USPTO that the '328 patent application should be examined under the first-to-

1 file provisions of the America Invents Act (“AIA”) because it has at least one claim with an
 2 effective filing date after March 16, 2013.

3 231. Upon information and belief, Abhyanker, a licensed patent attorney, knew that the
 4 ’531 application, purportedly a continuation but in fact a continuation-in-part filed in 2014 and
 5 containing new matter, had at least one claim with an effective date after March 16, 2013.

6 232. Nevertheless, Abhyanker did not check the box provided on a USPTO form to
 7 indicate that the ’531 application should be examined under AIA rules, upon information and
 8 belief, with the specific intent of deceiving the USPTO and avoiding prior art, such as the public
 9 use of Fatdoor services.

10 233. Had Abhyanker properly indicated that the ’531 application should be examined
 11 according to the AIA, one or more claims would have been accorded the March 10, 2014 ’531
 12 application filing date, and the USPTO would have rejected those claims in view of Kaplan.

13 234. Abhyanker’s contention that the ’531 application should be examined according to
 14 pre-AIA rules misrepresented information material to patentability.

15 235. Upon information and belief, Abhyanker specifically intended to deceive the
 16 USPTO as to whether the pending claims of the ’531 application were entitled to be examined
 17 under pre-AIA rules.

18 **Failure to Disclose References Relied on by USPTO During the Prosecution of the ’844**
 19 **Application**

20 236. The ’091 patent that issued on the ’844 application discloses and claims similar
 21 subject matter as the ’328 application. The ’091 patent claims to be a continuation-in-part of the
 22 ’194 application, and the ’328 claims to be a continuation of the ’194 application.

23 237. Accordingly, material prior art to the ’844 application would also have been
 24 material prior art to the ’531 application.

25 238. The USPTO cited several references in support of the non-final rejection of the
 26 ’844 application on March 17, 2014. These include U.S. Patent No. 8,650,103, by Wilf et al.
 27 (“Wilf”); Publication No. US-2013/0282842, by Blecon et al. (“Blecon”); Publication No. US-
 28 2011/0231268, by Ungos (“Ungos”); and an article from Wired.com entitled “Fatdoor CEO Talks

1 about balancing security with community,” by Russell (“Russell”).

2 239. That the USPTO cited these references in support of its rejection of the ’844
3 application confirms that the USPTO would have considered them prior art material to the
4 patentability of the ’531 application.

5 240. Abhyanker nonetheless did not disclose Wilf, Blecon, Ungos, or Russell during
6 prosecution of the ’513 application even though he knew that the USPTO would have considered
7 them to be prior art material to patentability.

8 241. Upon information and belief, Abhyanker specifically intended to deceive the
9 USPTO as to the existence of material prior art such as Wilf, Blecon, Ungos, and Russell.

Failure to Disclose Nextdoor.com Website

10 242. Abhyanker also did not disclose the existence of Defendant’s website,
11 Nextdoor.com, and services and features provided therein, in an information disclosure statement
12 during prosecution of the ’531 application.

13 243. Nextdoor.com launched to the general public in October 2011, although it had
14 been in public beta testing since early 2011.

15 244. Given that Abhyanker has accused the Nextdoor.com website of infringing the
16 ’328 patent, Abhyanker knew that the USPTO would have considered the Nextdoor.com website
17 material to patentability.

18 245. Upon information and belief, and in view of Abhyanker’s knowledge that his
19 claims of priority were improper, as well his contemporaneous knowledge of the USPTO’s
20 rejection of such a priority date in connection with the ’612 application that led to the ’545 patent,
21 as explained below, Abhyanker knew that the USPTO would have considered Nextdoor.com to
22 be prior art material to the patentability of the ’531 application.

23 246. Abhyanker nonetheless did not disclose the Nextdoor.com website during
24 prosecution of the ’531 application even though he knew that the USPTO would have considered
25 it to be prior art material to patentability.

26 247. Upon information and belief, Abhyanker specifically intended to deceive the
27 USPTO as to the existence of material prior art such as the Nextdoor.com website.

Conclusion

248. In sum, on information and belief, Abhyanker, the inventor and patent attorney for the '328 patent, misrepresented and omitted material information with the intent to deceive the USPTO to ensure the issuance of the '328 patent.

249. By reason of this inequitable conduct, the '328 patent and all related patents are unenforceable.

250. Absent a declaration of unenforceability of the '328 patent, Fatdoor is likely to continue to pursue claims of infringement with respect to the '328 patent against Nextdoor and will in this way cause damage to Nextdoor.

251. The '328 patent is further unenforceable as a result of Abhyanker's inequitable conduct committed during the prosecution of related applications, including without limitation U.S. Patent Application Nos. 14/151,844 and 14/144,612, addressed above.

252. Accordingly, Nextdoor seeks a declaration that the '328 patent is unenforceable.

PRAYER FOR RELIEF

WHEREFORE, Nextdoor requests relief against Fatdoor and Abhyanker as follows:

a. For a judgment in favor of Nextdoor denying Abhyanker and Fatdoor all relief requested in the Complaint and dismissing their Complaint with prejudice;

b. For a judgment against Abhyanker and Fatdoor declaring that Nextdoor has not and does not infringe any valid and enforceable claim of the '328 patent;

c. For a judgment against Abhyanker and Fatdoor declaring that one or more claims of the '328 patent are invalid and unenforceable;

d. For a judgment against Abhyanker and Fatdoor declaring that Nextdoor has not and does not infringe any valid and enforceable claim of the '091 patent;

e. For a judgment against Abhyanker and Fatdoor declaring that one or more claims of the '091 patent are invalid and unenforceable;

f. For a judgment against Abhyanker and Fatdoor declaring that Nextdoor has not and does not infringe any valid and enforceable claim of the '545 patent;

g. For a judgment against Abhyanker and Fatdoor declaring that one or more claims

1 of the '545 patent are invalid and unenforceable;

2 h. For a judgment against Abhyanker and Fatdoor declaring that the '328 patent is
3 unenforceable due to inequitable conduct;

4 i. For a judgment against Abhyanker and Fatdoor declaring that the '091 patent is
5 unenforceable due to inequitable conduct;

6 j. For a judgment against Abhyanker and Fatdoor declaring that the '545 patent is
7 unenforceable due to inequitable conduct;

8 k. For a judgment that this is an exceptional case within the meaning of 35 U.S.C.
9 § 285 and awarding Nextdoor its reasonable attorneys' fees;

10 l. For an award of costs to Nextdoor; and

11 m. Such other relief as the Court shall deem just and proper.

12

13

14 **DEMAND FOR JURY TRIAL**

15 Nextdoor hereby requests a trial by jury on all issues so triable.

16

17 Dated: August 1, 2014

FENWICK & WEST LLP

18 By: /s/ Michael J. Sacksteder
19 Michael J. Sacksteder

20 Attorneys for Defendant
NEXTDOOR.COM, INC.